#4

Attorney Docket No. ITI-169

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	KEVAN C. TAYLOR
Serial No.:	08/604,975
Filed:	March 25, 1996
International Application No.:	PCT/GB94/00995
International Filing Date:	9 May 1994
For:	LINING OF PIPELINES OR PASSAGEWAYS

Date: December 12, 1996

RENEWED PETITION UNDER 37 C.F.R. § 1.47(b)
IN RESPONSE TO DECISION ON PETITION
PURSUANT TO 37 C.F.R. § 1.47(b) DATED 12 JULY 1996

Assistant Commissioner for Patents
Box PCT
Washington, D.C. 20231

Attention: PCT Legal Office

S I R:

This Renewed Petition and the accompanying Declarations are submitted response to the Decision on Petition dated July 12, 1996, the response date having been extended pursuant to 37 C.F.R. § 1.136(a).

EXPRESS MAIL CERTIFICATE 37 CFR 1.10

Date of Deposit December 12, 1996

Express Mail Label No. EM 025 771 420 US

I hereby certify that this paper is being deposited with the U.S. Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to Commissioner of Patents and Trademarks, Washington, D.C. 20231

Michael Colon
Name of Person Mailing

Signature

Insituform Technologies, Inc. of Memphis, Tennessee ("ITI") is the ultimate corporate parent of all the Insituform companies, including Insituform (Netherlands) B.V., the 37 C.F.R. § 1.47(b) applicant herein.

Accompanying this Renewed Petition are the Declarations of (1) Mr. Regan L. Trumper identifying the several delivery attempts of letters sent to Mr. Taylor at his last known address in the United States and the results of those delivery attempts between 9 February 1996 and 4 October 1996; and (2) Mr. Andrew M. Donlan providing the complete details with respect to his attempts to communicate with Mr. Taylor at his last known address in the United Kingdom which are believed to satisfy items (2) and (3) identified in the discussion.

The Declaration of Dr. John W. Heavens sets forth detailed proof that the 37 C.F.R. § 1.47(b) applicant has sufficient proprietary interest in the invention based on personal knowledge. Mr. Taylor reported to Dr. Heavens during the time that Mr. Taylor made the invention in the United Kingdom while Mr. Taylor was employed by a related Insituform company of the 37 C.F.R. § 1.47(b) applicant.

Two additional Declarations are submitted based on facts discovered yesterday relating to Mr. Taylor's last known address. During routine confirmation of Mr. Taylor's dates of employment, ITI discovered that it had received a Request for Verification Employment of Mr. Taylor's with Insituform in connection with a loan application submitted by Mr. Taylor. This Request was

received by ITI on October 17, 1996 and set forth an address for Mr. Taylor in League City, Texas. These facts are set forth in the Declaration of Mr. Raymond P. Toth, the Vice President-Human Resources for ITI.

Immediately upon learning this information yesterday, the undersigned then forwarded to Mr. Taylor at this League City, Texas address a request to sign the application papers, both by Federal Express and Express Mail, including a paid return airbill and postage. These facts are set forth in the Declaration of Michael I. Wolfson in further support of the Renewed Petition. As soon as confirmation of delivery is received, this information will be provided to the PCT Legal Officer.

It is respectfully submitted that the additional facts set forth in the accompanying Declarations together with the facts set forth in the original Petition satisfy the requirements of 37 C.F.R. §1.47(b) and granting of the petition based on the facts and the following remarks is earnestly solicited.

The Legal Examiner identified three items in the Decision on Petition which required clarification. He stated that the Declarations of Mr. Trumper and Mr. Donlan are inadequate by failing to properly outline the steps taken to contact Mr. Taylor. Also, Mr. Taylor's last known address is not properly identified since efforts were made to reach him at two addresses. Finally, the Examiner considered that the Declaration of Mr. Martin does not establish that he has "firsthand knowledge of the facts that the

invention was made by the employee while employed by the 37 CFR 1.47(b) applicant."

The undersigned hereby renews the petitions pursuant to 37 C.F.R. 1.47(b) that the above identified application be accepted for filing in the national phase and that the 37 C.F.R. § 1.47(b) applicant be allowed to fully prosecute the application on the merits on behalf of and as agent for the inventor. This is based on the fact that the inventor could not be found or reached after diligent efforts between 9 February 1996 and 4 October 1996, and sufficient proprietary interest in the application has been demonstrated by firsthand knowledge.

DISCUSSION

This application is the U.S. national phase of PCT Application No. PCT/GB94/00995, filed 9 May 1994 and was deposited for filing in the U.S. Patent and Trademark Office on 25 March 1996, within the time limits of the Convention to receive priority of the PCT application and underlying British priority application. The application was filed without signature of the inventor, because the inventor was not found or reached after diligent efforts. Further diligent attempts have been made by the Declarants to obtain the signature of the inventor at his last known address here in the United States and at his last known address in the United Kingdom. Until yesterday, the last known address of the inventor to Declarants is in Memphis, TN. However, in an abundance of caution to a diligent effort was made to contact Mr. Taylor,

efforts by Mr. Donlan were also made to locate him at his previous address in the UK since Mr. Taylor left no forwarding address with ITI after his employment terminated.

Accordingly, as the Declarations accompanying this Petition demonstrate, 37 C.F.R. § 1.47(b) has now been satisfied as follows:

(1) Dr. John W. Heavens, Product Manager, Potable Water of Insituform Technologies, Inc. has confirmed ownership of the invention by an ITI subsidiary through the employment of Kevan Taylor, and based on his firsthand knowledge that the invention was made by Mr. Taylor during the period of that employment.

(2) Andrew M. Donlan has diligently attempted to reach and/or locate Mr. Taylor at his last known address in the U.K. without success. Mr. Donlan has provided an updated declaration detaining his efforts to locate Mr. Taylor in the UK. Mr. Donlan has sent three letters to Mr. Taylor's UK address, has provided proof of delivery, but has been unable to obtain any response from Mr. Taylor.

(3) Regan L. Trumper has diligently attempted to reach and/or locate Mr. Taylor at his last known address in the U.S. during the period from 9 February 1996 to 4 October 1996, without success. Mr. Trumper has provided an updated declaration detailing his initial effort to locate Mr. Taylor at his last known address in Memphis and identified the additional letters sent to Mr. Taylor in Memphis and has requested to Federal Express that they attempt numerous deliveries. Mr. Trumper has received no response from Mr. Taylor.

(4) Raymond P. Toth, Vice President-Human Resources of ITI, yesterday while confirming Mr. Taylor's dates of employment yesterday discovered that a Request for Verification of Employment of Mr. Taylor's had been received by another office at ITI on October 17, 1996. This Request for Verification identified Mr. Taylor's address as 501 Davis Road, #H201, League City, Texas 77573. As soon as this information was discovered, Mr. Toth provided this information to the undersigned.

(5) Michael I. Wolfson, the undersigned attorney for Petitioner, immediately upon being advised of the League City, Texas address for Mr. Taylor, prepared new application papers and forwarded them to Mr. Taylor both by Federal Express and Express Mail. A prepaid return airbill and postage were provided to Mr. Taylor to facilitate his return of the documents to the undersigned. As soon as delivery information with respect to these communications is received, the undersigned will provide to the PCT Legal Officer.

Kevan Taylor, the inventor of the application was under an obligation pursuant to the Patents Act 1977 of the United Kingdom to assign the invention described in the application to his employer (an Insituform subsidiary). The facts supporting applicability of the statute to Mr. Taylor are set forth in Dr. Heavens' Declaration. Thus, proof of a proprietary interest to the invention of this application has been established. A copy of the text of Section 39 Patents Act 1977 is attached to the Declaration of Michael I. Wolfson as Exhibit B.

This statutory provision provides that for inventions made on or after June 1, 1978 by an employee who is mainly employed in the United Kingdom shall belong to the employer if it was made in the course of (a) the normal duties of the employee or of duties specifically assigned to him, and the circumstances in either case or such that an invention might reasonably be expected to result from the carrying route or his duties; or (b) the duties of the employee which were of such a nature that they gave rise to particular responsibilities so that the employee had a special obligation to further the interest of the employer's undertaking.

Dr. Heavens has established that Mr. Taylor was employed in the United Kingdom under circumstances such that an invention might reasonably be expected. This is particularly true since Mr. Taylor was assigned to develop a laterals program for Insituform. These facts clearly establish that Mr. Taylor's duties were such that they gave rise to the particular circumstances called for by Section 39 Patents Act 1977. Confirming this is the provision in Mr. Taylor's July 3, 1993 Agreement with ITI, wherein Paragraph 13(a) specifically provides that Mr. Taylor "will be deemed to have a special obligation to further the interest of the company". This Agreement is annexed to the Declaration of William A. Martin dated March 20, 1996 and submitted in support of the original Petition.

Filing of the application by the 37 C.F.R. § 1.47 (b) applicant is necessary to preserve the rights of Insituform and to prevent irreparable damage. The priority date of the underlying application, is 25 September 1993, within the 30 month limit

allowed by the Patent Cooperation Treaty and 35 U.S.C. § 119, and the U.S. application is therefore entitled to the priority date of the PCT application. Insituform will be irreparably harmed by the loss of this priority date and will not be able to preserve its rights to this invention under Title 35 if this Petition is denied.

Petitioner has attempted to respond fully to the Legal Examiner's Decision on Petition and respectfully requests a favorable response to this Renewed Petition and that Petitioner be allowed to fully prosecute this application on the merits on behalf of and as agent for the inventor. The facts learned yesterday should not detract from the diligent efforts made to reach Mr. Taylor from February to early October 1996. Multiple attempts to reach him were made at his then last known address. Thus, the requirement of 37 C.F.R. § 1.47(b) have been completely met.

If there is any question with respect to this Petition, kindly contact the undersigned attorney by telephone so that any outstanding issue can be quickly resolved.

Respectfully submitted,

Michael I. Wolfson
Reg. No. 24,750
Attorney for Petitioner and
37 C.F.R. § 1.47(b) Applicant
COWAN, LIEBOWITZ & LATMAN, P.C.
1133 Avenue of the Americas
New York, New York 10036-6799
(212) 790-9200

Enclosures

#4

24 Rec'd PCT/PTO 13 DEC 1996

Attorney Docket No. ITI-169

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	KEVAN C. TAYLOR
Serial No.:	08/604,975
Filed:	March 25, 1996
PCT Serial No.:	PCT/GB94/0095
Priority Date:	September 25, 1993
For:	LINING OF PIPELINES OR PASSAGEWAYS

DECLARATION OF ANDREW M. DONLAN IN SUPPORT OF PETITION PURSUANT TO 37 C.F.R. § 1.47(B)

Assistant Commissioner of Patents
Box PCT
Washington, D.C. 20231

Attn: PCT Legal Office

S I R:

ANDREW M. DONLAN, hereby declares, as follows:

1. I am associated with Bailey Walsh & Co., 5 York Place, Leeds LSI 2SD, England, Chartered Patent Agents and European Patent Attorneys for Insituform Technologies, Inc. ("ITI"), located at 1770 Kirby Parkway, Suite 300 Memphis, TN 38138, at the time of filing the applications involved herein.

2. Upon information and belief, Kevan Charles Taylor, the inventor of the subject matter described and claimed in the above identified application, was originally employed in the United

Kingdom by Insituform Technical Services Limited, a U.K. subsidiary of ITI or its predecessor companies on 4 December 1989. Based on Insituform records in the United Kingdom, he last resided in the United Kingdom at Cynon, Neweys Hill, Worcester, WR3 7D2, Great Britain.

3. On 11 January 1996, pursuant to instructions from Cowan, Liebowitz & Latman, P.C., the U.S. attorneys for Insituform, I forwarded to Kevan Taylor a United States application Declaration and Assignment document for his signature for this application in order to enter the National Phase in the United States. A copy of my letter of transmittal is annexed as Exhibit A.

4. On 9 February 1996, I again wrote to Kevan Taylor, by Recorded Delivery, to request that he sign and return the Declaration and Assignment documents which I had previously sent to him and to remind him of my previous letter. I requested in this 9 February 1996 letter that he contact me if for whatever reason he was unwilling to complete the forms. A copy of my letter of 9 February 1996 is annexed as Exhibit B.

5. It is standard practice to contact the Post Office to confirm delivery of documents sent by Recorded Delivery. This was undertaken at the time of the sending of the 9 February 1996 letter identified above in paragraphs 4 and again on 2 September

1996. I received confirmation from the Post Office that on each occasion the document had been delivered.

6. On February 26, 1996, I sent a third letter to Mr. Taylor reminding him of my previous attempts to have him execute the mentioned critical documents and again requesting that he do so. Attached as Exhibit C is a copy of my February 26, 1996 letter.

7. Attached as Exhibit D and E, respectively, is a Royal Mail delivery card receipt indicating that the letters of 11 January 1996 and 9 February 1996, were received by and signed for by Mrs. J. Taylor, whom I understand to be Kevan Taylor's wife.

8. To date, I have not received any communication whatsoever from Kevan Taylor in relation to this matter. The first two letters which I sent identified above were received at his home by his wife who accepted and signed for these letters indicated by the Royal Mail delivery cards of Exhibits D and E.

9. Prior to filing the British priority application on 25 August 1993, Kevan C. Taylor sent completed drawings of the invention as described and claimed in this application Mr. James Denmark of my Office. This transmission showing completion of the invention is dated prior to the British priority application filing date. A copy of this communication is annexed as Exhibit D.

10. Under the Patents Act 1977 (as amended by the Copyright Designs and Patents Act 1988) provides that inventions made after June 1, 1978 by an employee who is mainly employed in the United Kingdom shall belong to the employer if it was made in the course of (a) the normal duties of the employee, or (b) the duties of the employee were of such nature that they gave rise to particular responsibilities so that the employee had a special obligation to further the interest of the employers undertaken.

11. Based on the facts the inventor has not been reachable or locatable in the U.K. and has been unresponsive to at least verified attempts bona fide to reach him. I, have information to believe that he was employed by ITI in the United States, but is no longer employed by ITI. Accordingly, on behalf of Insituform, request acceptance of this application and petition and that Insituform be allowed to fully prosecute said application on the merits on behalf of and as agent for Kevan C. Taylor, the inventor.

12. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United

States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Andrew M. Donlan

Date: December 11, 1996

Exhibit A

Mr K C Taylor
Cynon
Neweys Hill
Worcester
WR3 7D2

Our Ref: AD/6995
11 January 1996

Dear Mr Taylor

Re: USA National Phase Patent Application
Based on PCT/GB94/00995
Insituform (Netherlands) BV
Short-Tee Repair Systems for Laterals

As I am sure you will recall we have been in correspondance regarding the patent protection of the above invention. On the instructions of Insituform we have arranged for the filing of a National phase application in USA out of the above International Patent Application, a copy of which is attached hereto. To complete the necessary formalities for filing the US patent application would you please sign the enclosed Power of Attorney form where indicated and also the enclosed assignment form. If possible please sign the latter form before a notary public.

On completion of the forms please return them to me as soon as possible. Thank you in anticipation of your continued assistance in this matter.

Yours sincerely
BAILEY WALSH & CO

ANDREW M DONLAN

Exhibit B

Mr K C Taylor
Cynon
Neweys Hill
Worcester
WR3 7DZ

Our Ref: AD/SR/6995

9 February ~~1996~~ 8/3

RECORDED DELIVERY

Dear Mr Taylor

Re: Canadian National Phase Application
Based on International Patent Application
No. PCT/GB94/00995 - Shortee Repair Systems for Laterals)

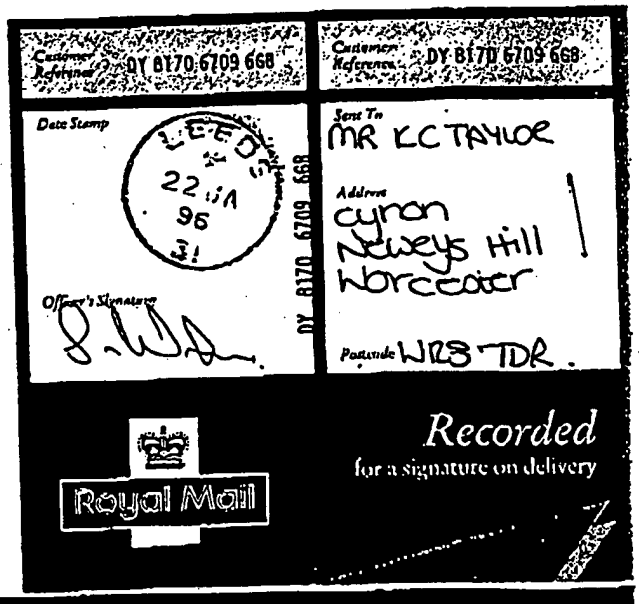
Further to my letter of 11 January 1996 relating to the U.S. equivalent case in relation to the above, please be informed that we have now received notification from our Canadian Associate that we require an Assignment to be completed by you in relation to the above application and we enclose the Assignment document herewith. Could you please arrange to sign this document before a witness and have the witness complete the witness statement on the form. It will be appreciated if you could return this document to me at your earliest convenience.

I would also remind you of my letter of 11 January 1996 enclosing a Power of Attorney and Declaration form and Assignment form in relation to the US application based on the above International application and would appreciate receiving that at your earliest convenience. If for some reason you are unwilling to complete this form it would be appreciated if you could let me know at your earliest convenience.

Yours sincerely
BAILEY WALSH & CO

A DONLAN

Enc:



Mr K C Taylor
Cynon
Neweys Hill
Worcester WR3 7DZ

Our ref: AD/PW/6995
26th February 1996
11/3

RECORDED DELIVERY

Dear Mr Taylor

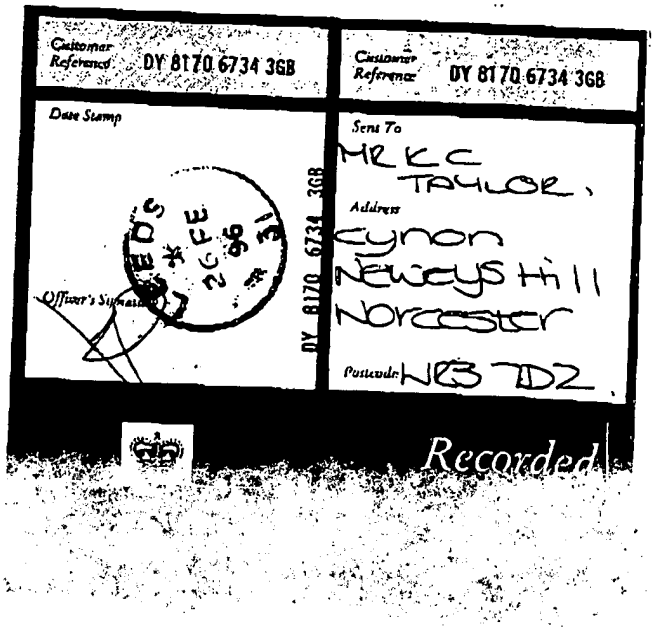
Re: Canadian and US National Phase Applications
based on International Patent Application
No PCT/GB94/00995 - Insituform Netherlands BV
SHORTEE REPAIR SYSTEMS FOR LATERALS

I refer you to my letters 2nd January and 9th February 1996 in relation to the above and look forward to receiving the completed assignment documents at your earliest convenience.

Should you have any problems in relation to the completion of these documents it would be much appreciated if you could advise me accordingly at your earliest convenience.

Yours sincerely
BAILEY WALSH & CO

A DONLAN



[redacted] [redacted] Exhibit D

PRIORITY SERVICES

Delivery Card

Please peel the barcode from the item and stick it onto this form. The person accepting the delivery should sign,print their name and record the time.

card no. [ ]

--------*of*---------

Royal Mail

date stamp

CROYDON DELIVERY OFFICE 23 JAN 1996

walk ID 01541 1

walk name

barcodes (*please affix in the spaces below*)

DY 8170 6709 6GB

no. guaranteed items for delivery	no. Recorded items for delivery	no. returned items
—	1	

no. delivered items	no. items pouched off	Delivery card confirmed on track/trace
1		(PHG *initials*)

signature M. Taylor PRINT name 1 MICHAEL TAYLOR	time 0745
signature PRINT name 2	time
signature PRINT name 3	time

p 4550 Feb 95
304181

Exhibit E

PRIORITY SERVICES

Delivery Card

Please peel the barcode from the item and stick it onto this form. The person accepting the delivery should sign,print their name and record the time.

card no. [ ]

-------*of*--------

Royal Mail

date stamp

WORC 27 FEB 1996

walk ID 0|5|4|1

walk name

barcodes *(please affix in the spaces below)*

XX 0505 3184 5GB

DY 8170 6734 3GB

no. guaranteed items for delivery	no. Recorded items for delivery	no. returned items
1	1	

no. delivered items	no. items pouched off	Delivery card confirmed on track/trace (PHG *initials*)

signature [illegible]	time
PRINT name [illegible]	9.25
signature [illegible]	time
PRINT name MRS J TAYLOR 2	9.25
signature	time
PRINT name 3	

p 4550 Feb 95
304181

#4

Attorney Docket No. ITI-169

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	KEVAN C. TAYLOR
Serial No.:	08/604,975
Filed:	March 25, 1996
PCT Serial No.:	PCT/GB94/0095
Priority Date:	September 25, 1993
For:	LINING OF PIPELINES OR PASSAGEWAYS

DECLARATION OF REGAN L. TRUMPER IN SUPPORT OF RENEWED PETITION PURSUANT TO 37 C.F.R. § 1.47(b)

Assistant Commissioner of Patents
Box PCT
Washington, D.C. 20231

Attention: PCT Legal Office

S I R:

REGAN L. TRUMPER, hereby declares, as follows:

1. I am an associate at Cowan, Liebowitz & Latman, P.C., 1133 Avenue of the Americas, New York, New York 10036, Patent Counsel for Insituform Technologies, Inc., located at 1770 Kirby Parkway, Suite 300 Memphis, TN 38138 ("ITI"), the ultimate corporate parent of Insituform (Netherlands) B.V., the 37 C.F.R. § 1.47(b) applicant herein.

2. Upon information and belief, Kevan Charles Taylor, the inventor of the above identified application, on 4 December 1989, became an employee of Insituform Technical Services Limited in the United Kingdom and was subsequently employed by ITI in July

1993, and located in the United Kingdom until the filing of the British priority application in on 25 September 1993.

3. Based on the employment records of ITI at the time of filing this application on 25 March 1996, Mr. Taylor's last known address in the United States was 3226 Knight Lane, Apt. No. 258, Memphis, TN 38115. Mr. Taylor is no longer employed by ITI and has not left a forwarding address with ITI.

4. On February 9, 1996, I forwarded to Kevan Taylor via Federal Express, at his last known address, an Assignment document for his signature for this application. A copy of my letter of transmittal is annexed as Exhibit A.

5. On or around February 16, 1996, I received a telephone call from the Customer Service department of Federal Express informing me that they had been unable to deliver my 9 February 1996 letter despite three (3) delivery attempts. I requested that they attempt to deliver the package again and then return the it to me.

6. By notification dated 21 February 1996, Federal Express notified me that the package was undeliverable to Kevan Taylor at the Knight Lane address. A copy of this notification is annexed as Exhibit B.

7. On 23 August 1996, I again attempted to contact Kevan Taylor via Federal Express, United States Postal Service Express Mail and regular First Class mail to request that he sign and return the enclosed application Declaration, Power of Attorney

and Petition and Assignment to Insituform (Netherlands) B.V. A copy of this letter is annexed as Exhibit C.

8. Federal Express tracking information has advised me that this 23 August 1996 letter was delivered to Mr. Taylor's last known address and signed for by an "L. Loeffel" on 26 August 1996. This person is unknown to declarant and a further letter was sent to the same address as a follow up as detailed in paragraph 10, et. seq. below. A copy of this tracking information is annexed as Exhibit D.

9. The Postal Service attempted delivery of the 23 August 1996 Express Mail letter on August 25, 26 and 29, but was unable to deliver the letter. The Postal Service then returned the Express Mail letter to me. A copy of the Express Mail Label is annexed as Exhibit E.

10. As a further follow-up to the Federal Express delivery of 23 August 1996 letter, I sent a third letter to Mr. Taylor on 4 October 1996 by Federal Express. A copy of this letter is annexed as Exhibit F.

11. Federal Express contacted me shortly thereafter informing me that they were unable to make delivery and requesting instructions. I requested that they make at least three more delivery attempts before returning the letter. The 4 October 1996 letter was returned undeliverable on 2 December 1996.

12. To date, I have not received any communication whatsoever from Mr. Taylor in relation to this matter despite my

numerous attempts and follow-ups to locate and communicate with Mr. Taylor at his last known address in the United States.

13. Based on the facts the inventor has not been reachable or locatable in the U.S. after I made three bona fide attempt between 9 February 1996 and 4 October 1996 to so locate, I, on behalf of Insituform (Netherlands) B.V., request acceptance of this application and petition and that the 37 C.F.R. § 1.47(b) applicant be allowed to fully prosecute said application on the merits on behalf of and as agent for the inventor.

14. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Regan L. Trumper

Dated: New York, New York
December 12, 1996

Exhibit A

Cowan, Liebowitz & Latman, P.C.

LAW OFFICES

1133 Avenue of the Americas • New York, NY 10036-6799

Telephone (212) 790-9200 • *Internet* law@cll.com • *Fax* (212) 790-9300

Regan L. Trumper
Direct (212) 790-9245
rlt@cll.com

February 9, 1996

FEDERAL EXPRESS

Mr. Kevan Taylor
3226 Knight Lane
Apartment No. 258
Memphis, TN 38115

Re: National Phase application in the U.S.
Based on International Patent Application
No. PCT/GB94/00955
LINING OF PIPELINES AND PASSAGEWAYS (Short-Tee Repair)
Insituform (Netherlands) BV
Our Ref. ITI-169 (20107.69)

Dear Mr. Taylor:

Attached you will find an Assignment form for the filing of the U.S. application for the above identified application. This application corresponds to the same previous application which was filed in the PCT.

We ask that you sign this Application and have your signature notarized. Thereafter, please return the executed document to us so that we can have it properly filed with the Patent and Trademark Office.

We look forward to your prompt response and should you have any questions, please do not hesitate to contact us.

Sincerely yours,

Regan L. Trumper

Enclosure

Federal Express Corporation Tel[redacted] 1-5355

Exhibit B

FedEx
Federal Express

Date: 2-21-96

Cowan Liebowitz Latman
1133 Ave. of Americas
New York NY 10036
Attn: Regan Trumper

Ref. FEC AB# 757711982 6

Dear Customer:

Your shipment dated 2-9-96 to Kevan Taylor
was undeliverable for the following reason(s):

- ✓ Recipient did not pick-up package
- ____ Unable to locate recipient
- ____ Incorrect address
- ____ Package refused by recipient
- ____ Recipient not in on several delivery attempts
- ____ Business closed
- ____ Damaged - Delivery refused
- ____ International Air Waybill/Commercial Invoice
- ____ Dangerous Goods/ Incomplete paperwork
- ____ Package received at Destination Station without airbill
- ____ Other _____

We are returning this shipment to you at no additional charge via our Economy/ Two Day Service. Please call us at 1-800-238-5355 if you have any further questions regarding this matter. Thank you.

Sincerely,

Customer Service
Federal Express Corporation

Exhibit C

Cowan, Liebowitz & Latman, P.C.

LAW OFFICES

1133 Avenue of the Americas • New York, NY 10036-6799

Telephone (212) 790-9200 • *Internet* law@cll.com • *Fax* (212) 790-9300

Regan L. Trumper
Direct (212) 790-9245
rlt@cll.com

August 23, 1996

EXPRESS MAIL

Kevan Taylor
3226 Knight Lane
Apartment No. 258
Memphis, TN 38115

Re: National Phase application in the U.S.
Based on International Patent Application
No. PCT/GB94/00955
LINING OF PIPELINES AND PASSAGEWAYS (Short-Tee Repair)
Insituform (Netherlands) BV
Our Ref. ITI-169 (20107.69)

Dear Mr. Taylor:

Attached you will find an Assignment form for the filing of the U.S. application for the above identified application. This application corresponds to the same previous application which was filed in the PCT.

We ask that you sign this Application and have your signature notarized. Thereafter, please return the executed document to us so that we can have it properly filed with the Patent and Trademark Office.

We look forward to your prompt response and should you have any questions, please do not hesitate to contact us.

Sincerely yours,

Regan L. Trumper

Enclosure

Exhibit D

FedEx

BILL TO: COWAN LIEBOWITZ LATMAN
1133 AVE OF AMERICAS/36TH FLR
NEW YORK, NY 10036

REFERENCE ACTIVITY SUMMARY

DATE 09/05/9
INVOICE NO. 5-911-25114 ACCOUNT NO. 0101-0074-

TRACKING NOS REFERENCE	SENDER'S NAME AND ADDRESS	RECIPIENT INFORMATION AND PROOF OF DELIVERY	PACKAGES & WEIGHT	SERVICES	CHARGES	NET CHARGES
6803830003 CC NO REFERENCE INFORMATION 24108075 1	BAILA CELEDONIA COWAN LIEBOWITZ LATMAN 1133 AVE OF AMERICAS/36TH FLR NEW YORK, NY 10036 SHIPPED 08/23/96	PATTI TURNER CINCINNATTI BAR ASSN 8TH FL 35 EAST SEVENTH ST CINCINNATI, OH 45202 A1 DELIVERED:08/26/96 09:45 SIGNED: M.MARKS	1/ NA	PRIORITY LTR DISCOUNT	15.50 -5.00	10.50
8494760024 20107 NO REFERENCE INFORMATION 24108075 1	REGAN L TRUMPER COWAN LIEBOWITZ LATMAN 1133 AVE OF AMERICAS/36TH FLR NEW YORK, NY 10036 1ST ATTEMPT 08/26/96 08:57 08 SHIPPED 08/23/96	MR KEVAN TAYLOR 3226 KNIGHT LANE APT N 258 MEMPHIS, TN 38115 A1 DELIVERED:08/26/96 12:20 SIGNED: L.LOEFFEL	1/ NA	PRIORITY LTR DISCOUNT	15.50 -5.00	10.50
8494760042 20107 NO REFERENCE INFORMATION 23724217 1	MICHAEL WOLFSON COWAN LIEBOWITZ LATMAN 1133 AVE OF AMERICAS/36TH FLR NEW YORK, NY 10036 02 DROP OFF 08/23/96	MICHAEL WOLFSON 15 COACHLAMP LN GREENWICH, CT 06830 AA DELIVERED:08/24/96 10:49 SIGNED: 1525134	1/ 9	PRIORITY BOX DISCOUNT SAT SERVICE	43.50 -5.22 10.00	48.28
				CONTINUED NEXT PAGE		

QUESTIONS? CALL OUR CUSTOMER ACCOUNT SERVICES, 800-622-1147, 7AM - 6PM (CST) MONDAY - FRIDAY.
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MAIL TO: FEDERAL EXPRESS CORP., P.O. BOX 1140, MEMPHIS, TN 38101 - 1140.

M-0145 7/96

FedEx

BILL TO: COWAN LIEBOWITZ LATMAN
1133 AVE OF AMERICAS/36TH FLR
NEW YORK, NY 10036

REFERENCE ACTIVITY SUMMARY

DATE 09/05/9
INVOICE NO. 5-911-25114 ACCOUNT NO. 0101-0074-

TRACKING NOS REFERENCE	SENDER'S NAME AND ADDRESS	RECIPIENT INFORMATION AND PROOF OF DELIVERY	PACKAGES & WEIGHT	SERVICES	CHARGES	NET CHARGES
7577169633 135/03 NO REFERENCE INFORMATION 24104786 1	M KARLIN COWAN LIEBOWITZ LATMAN 1133 AVE OF AMERICAS/36TH FLR NEW YORK, NY 10036 DROP OFF 08/27/96	DAVID WOODS ASSOCIATED INVESTIGATIVE SVCS 70-20 AUSTIN STREET FLUSHING, NY 11375 A1 DELIVERED:08/28/96 09:24 SIGNED: K.LALLY	1/ NA	PRIORITY LTR DISCOUNT	15.50 -5.00	10.50
5878480458 165326 NO REFERENCE INFORMATION 23213016 1	CONSULATE OF VENEZUELA EAST 51ST ST NEW YORK CITY, NY 10001 DROP OFF 08/14/96	SUSAN SANTANIELLO COWAN LIEBOWITZ &LATMAN P C 1133 AVENUE OF THE AMERICAS 3 NEW YORK, NY 10036 A1 DELIVERED:08/15/96 09:36 SIGNED: E.KING	1/ NA	PRIORITY LTR DISCOUNT	15.50 -5.00	10.50
7624809905 160377 NO REFERENCE INFORMATION 24208170 1	RICHARD MANDELL COWAN LIEBOWITZ LATMAN 1133 AVE OF AMERICAS/36TH FLR NEW YORK, NY 10036 SHIPPED 08/28/96	RICHARD MANDELL COWAN LIEBOWITZ & LATMAN 1133 AVENUE OF THE AMERICA'S NEW YORK, NY 10036 A1 DELIVERED:08/29/96 09:21 SIGNED: D.CLASS	1/ NA	PRIORITY LTR DISCOUNT	15.50 -5.00	10.50
				CONTINUED NEXT PAGE		

QUESTIONS? CALL OUR CUSTOMER ACCOUNT SERVICES, 800-622-1147, 7AM - 6PM (CST) MONDAY - FRIDAY.
TO ENSURE PROPER CREDIT PLEASE RETURN THE REMITTANCE ADVICE (1ST PAGE OF THIS INVOICE) WITH YOUR PAYMENT.
MAIL TO: FEDERAL EXPRESS CORP., P.O. BOX 1140, MEMPHIS, TN 38101 - 1140.

M-0145 7/96

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BILL TO: COWAN LIEBOWITZ LATMAN
1133 AVE OF AMERICAS/36TH FLR
NEW YORK, NY 10036

REFERENCE ACTIVITY SUMMARY

DATE 09/05/
INVOICE NO. 5-911-25114 ACCOUNT NO. 0101-0074

TRACKING NOS REFERENCE	SENDER'S NAME AND ADDRESS	RECIPIENT INFORMATION AND PROOF OF DELIVERY	PACKAGES & WEIGHT	SERVICES	CHARGES	NET CHARGES
9616214381 NO REFERENCE INFORMATION 24329699 1	BEVERLY WRIGHT USISG 14497 N DALE MABRY TAMPA, FL 33618 SHIPPED 08/28/96	MR ABE ABRAMS LONG ISLAND 1733 ANDREA RD EAST MEADOW, NY 11554 AA DELIVERED:08/29/96 10:07 SIGNED: A.ABRAHMS	1/ NA	PRIORITY LTR DISCOUNT	15.50 -5.00	10.5
		REFERENCE SUBTOTAL	155.53	CONTINUED NEXT PAGE		

QUESTIONS? CALL OUR CUSTOMER ACCOUNT SERVICES, 800-622-1147, 7AM - 6PM (CST) MONDAY - FRIDAY.
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MAIL TO: FEDERAL EXPRESS CORP., P.O. BOX 1140, MEMPHIS, TN 38101 - 1140.

M-0145 7/96

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ADDRESSEE COPY

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☐ Merchandise
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Date In 8 23 96 Mo. Day Yr.	☐ 12 Noon ☐ 3 PM	Postage $ 10.75	Return Receipt Fee
Time In ☐ AM ☐ PM	Military ☐ 2nd Day ☐ 3rd Day	COD Fee	Insurance Fee
Weight lbs. oz.	Int'l Alpha Country Code	Total Postage & Fees $ 10.75	
No Delivery ☐ Weekend ☐ Holiday	Acceptance Clerk Initials		

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Delivery Attempt Mo. 8 Day 25	Time ☑ AM ☐ PM	Employee Signature
Delivery Attempt Mo. 8 Day 26	Time ☑ AM ☐ PM	Employee Signature
Date of Delivery Mo. 9 Day 20	Time ☐ AM ☐ PM	Employee Signature

Signature of Addressee or Agent
X

Name - Please Print
X

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Regan L. Trump
Communicate Quality
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New York, NY 10020
(212) 391-7...

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TO: (PLEASE PRINT) PHONE

Kevin Taylor
... Knight ...

3. ATTACH LABEL
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FOR PICKUP
Call 1-800-222-1811 for our scheduled pickup ... drop off ...

Exhibit E

36

LABEL 11-B 5/94

Exhibit F

Cowan, Liebowitz & Latman, P.C.

LAW OFFICES

1133 Avenue of the Americas • New York, NY 10036-6799

Telephone (212) 790-9200 • *Internet* law@cll.com • *Fax* (212) 790-9300

Regan L. Trumper
Direct (212) 790-9245
rlt@cll.com

October 4, 1996

FEDERAL EXPRESS

Mr. Kevan Taylor
3226 Knight Lane
Apartment No. 258
Memphis, TN 38115

Re: National Phase application in the U.S.
Based on International Patent Application
No. PCT/GB94/00955
LINING OF PIPELINES AND PASSAGEWAYS (Short-Tee Repair)
Insituform (Netherlands) BV
Our Ref. ITI-169 (20107.69)

Dear Mr. Taylor:

I am contacting you in reference to my August 23, 1996, letter regarding the above identified matter. By my previous letter, I forwarded to you an Assignment and a Declaration, Power of Attorney and Petition with a request that they be signed and returned to us.

As it has been almost six weeks since my previous letter, I ask that you promptly sign and return the documents to us so that we can have them promptly filed with the U.S. Patent and Trademark Office.

If you have any questions or problems in relation to completing these documents, please feel free to contact me at your earliest convenience to discuss the matter.

RLT/RLT/20107/69/218714.01

In the absence of a response from you, we will complete our efforts to formalize the filing of this application without your signature.

Sincerely yours,

Regan L. Trumper

cc: Insituform Technologies, Inc.

Attorney Docket No. ITI-169

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	KEVAN C. TAYLOR
Serial No.:	08/604,975
Filed:	March 25, 1996
International Application No.:	PCT/GB94/00995
International Filing Date:	9 May 1994
For:	LINING OF PIPELINES OR PASSAGEWAYS

DECLARATION OF MICHAEL I. WOLFSON
IN SUPPORT OF RENEWED PETITION UNDER 37 C.F.R. § 1.47(b)

Assistant Commissioner for Patents
Box PCT
Washington, D.C. 20231

Attention: PCT Legal Office

S I R:

MICHAEL I. WOLFSON, hereby declares as follows:

1. I am a partner at Cowan, Liebowitz & Latman, P.C., attorneys for Insituform Technologies, Inc., 1770 Kirby Parkway, Suite 300, Memphis, Tennessee 38138 ("ITI"). ITI is the ultimate corporate parent of all Insituform companies, including Insituform (Netherlands) B.V., the 37 C.F.R. § 1.47(b) applicant herein. I make this Declaration in support of the Renewed Petition to accept this application pursuant to 37 C.F.R. § 1.47(b) and DESCRIBE THE action I took yesterday upon learning of a new address for Kevan C. Taylor, the inventor who cannot be reached.

2. Yesterday, I consulted with ITI to confirm Mr. Taylor's dates of employment and establish that the original efforts to reach him of 9 February 1996 should have reached him since they were in fact to his last known address during his employment with ITI in Memphis. I was advised that ITI had received a Request for Verification of Employment (Fannie Mae Form 1005) in connection with a mortgage application filed by Mr. Taylor on 17 October 1996. A copy of this Request is annexed to Mr. Toth's Declaration, bears a received stamp of 17 October 1996 and identifies Mr. Taylor's address as 501 Davis Road, #H201, League City, Texas 77573.

3. Immediately upon learning this new address for Mr. Taylor, I prepared new application papers including a Declaration and Assignment for Mr. Taylor's signature. I included a pre-paid Federal Express airbill and a completed Express Mail airbill with postage to facilitate Mr. Taylor's return of the signed documents to me. A copy of the letter I forwarded to Mr. Taylor by Federal Express and Express Mail yesterday together with the enclosures, the return Federal Express airbill and envelope showing the completed Express Mail airbill and postage are annexed hereto as Exhibit A.

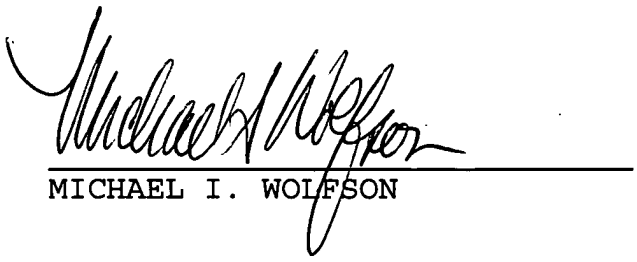
4. I anticipate that delivery attempts will be made on Mr. Taylor, both by Federal Express and Express Mail today. As soon as I receive confirmation whether the letters have been delivered, I will advise the PCT Legal Office of these facts.

5. I have reviewed the multiple efforts made by my office and Mr. Donlan in the U.K. to reach Mr. Taylor at his two last known

addresses and respectfully submit that these more than satisfy the diligent efforts required under 37 C.F.R. §1.47(b). All during the period from 9 February 1996 through 4 October 1996, when no less than six separate communications were forwarded to Mr. Taylor, none resulted in his contacting us or returning the application papers with his signature. All during this period, the last known address of Mr. Taylor was that maintained by ITI when he was employed by ITI in Memphis. In view of this, it is respectfully submitted that this Petition under 37 C.F.R. §.147(b) should be accepted.

6. Annexed hereto as Exhibit B is a copy of Section 39 Patents Act 1977.

7. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.



MICHAEL I. WOLFSON

Date: New York, New York
December 12, 1996

Exhibit A

Cowan, Liebowitz & Latman, P.C.
LAW OFFICES

1133 Avenue of the Americas • New York, NY 10036-6799

Telephone (212) 790-9200 • *Internet* law@cll.com • *Fax* (212) 790-9300

Michael I. Wolfson
Direct (212) 790-9201
miw@cll.com

December 11, 1996

FEDERAL EXPRESS and EXPRESS MAIL

Mr. Kevin C. Taylor
501 Davis Road #H201
League City, TX 77573

Re: U.S. Application Serial No. 08/604,975
Based on International Patent Application
No. PCT/GB94/00955
LINING OF PIPELINES AND PASSAGEWAYS (Short-Tee Repair)
Insituform (Netherlands) BV
Our Ref. ITI-169 (20107.69)

Dear Mr. Taylor:

We have been unsuccessful in reaching you after several attempts in order to have you sign the United States Declaration and Assignment in connection with this United States Application. This application is the United States national phase application based on your British and PCT applications filed in the United Kingdom relating to your Short-Tee Repair development.

In view of our inability to reach you after several attempts to your Knight Lane address in Memphis and your last known in the United Kingdom, we filed the application under Rule 47(b). This Rule permits the owner of an application to file the application without the inventor's signature if it has been unable to reach the inventor after diligent effort. We believe we have made this diligent effort. However, today we learned that you have utilized this League City address in a mortgage application and a verification of employment was sent to Insituform Technologies in Memphis in October of this year.

Our earlier efforts to reach you included letters to your Knight Lane address on February 9, 1996, August 23, 1996 and again on October 4, 1996. As noted, several attempts were also made by Andrew Donlon to contact you at Neweys Hill, Worcester. All these efforts to reach you have been unavailing.

In view of our obligation to make a diligent effort to obtain your signature, we enclose a new Declaration and Assignment for your signature. Please insert your address and sign and date the Declaration at page 2. Please sign the Assignment and have it notarized. Only the Assignment need be notarized.

We have enclosed prepaid Federal Express and Express Mail air bills to facilitate your returning the signed documents to us.

If you have any questions concerning any of these documents or the procedures we have followed in connection with this application, please feel free to contact us by collect call.

Please give this matter your prompt attention so that we can promptly advise the United States Patent and Trademark Office whether you have signed the application declaration or whether the Patent Office must make a decision to proceed pursuant to Rule 47(b).

Thank you for your cooperation with this matter.

Sincerely,

Michael I. Wolfson

cc: Insituform Technologies, Inc.
Memphis, Tennessee

Attorney Docket No. ITI-169

DECLARATION, POWER OF ATTORNEY AND PETITION

As an officer of the owner of the invention and Agent of the below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name.

I believe that the below named inventor is the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

IMPROVEMENTS RELATING TO THE LINING OF PIPELINES OR PASSAGEWAYS

the specification of which is attached hereto and was filed on 9 May 1994 as PCT/GB94/00995 and is based on an application filed in the British Patent Office as British Application No. 9319832.3 on 25 September 1993 and filed in the United States Patent and Trademark Office as Serial No. 08/604,975 on March 25, 1996.

I acknowledge the duty to disclose information which is material to the examination of this application in accordance with Title 37, Code of Federal Regulations, Section 1.56.

I hereby claim foreign priority benefits under Title 35, United States Code, Section 119 of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed.

Prior Foreign Applications				
(Number)	(Country)	Day/Month/Year	Yes	No
9319832.3	Great Britain	25 Sept 1993	X	
PCT/GB94/00995	Great Britain	9 May 1994	X	

I hereby claim the benefit under Title 35, United States Code, Section 120 of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, Section 112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, Section 1.56 which occurred between the filing date of the prior application and the national or PCT international filing date of the application.

(App Ser No) (Filing Date) (Status)

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that

these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

And I hereby appoint Michael I. Wolfson, Reg. No. 24,750, William H. Dippert, Reg. No. 26,723, R. Lewis Gable, Reg. No. 22,479, Morey B. Wildes, Reg. No. 36,968 and Regan L. Trumper, Reg. No. 38,345, correspondence address:

MICHAEL I. WOLFSON
Cowan, Liebowitz & Latman, P.C.
1133 Avenue of the Americas
New York, New York 10036
Telephone: (212) 790-9200

my attorney with full power of substitution and revocation, to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith.

Wherefore I pray that Letters Patent be granted for the invention or discovery described and claimed in the foregoing specification and claims, and I hereby subscribe my name to the foregoing specification and claims, declaration, power of attorney, and this petition.

FULL NAME OF INVENTOR KEVAN CHARLES TAYLOR	CITIZENSHIP Great Britain
RESIDENCE	
POST OFFICE ADDRESS	

AGENT'S SIGNATURE	DATE

Attorney Docket No. ITI-169

ASSIGNMENT OF UNITED STATES PATENT APPLICATION

WHEREAS, KEVAN CHARLES TAYLOR, a citizen of Great Britian and last residing at _____, is the inventor of the improvements and invention described in the PCT Application No. PCT/GB94/00995 filed 4 May 1994 and British application filed in the British Patent Office as application number 9319832.3 on 25 September 1993 for LINING OF PIPELINES AND PASSAGEWAYS, and filed in the U.S. Patent and Trademark Office concurrently herewith.

WHEREAS, Insituform (Netherlands) B.V., a coproration organized under the laws of The Netherlands and Delaware, having its principal office at West Blaak 6, 3rd Floor, 3012KK, Rotterdam, The Netherlands, hereinafter referred to as ASSIGNEE, is desirous of acquiring the entire right, title and interest in, to and under the improvements and invention described in PCT Application No. PCT/GB94/00995 and the United States National Phase application Serial No. 08/604,975 from ASSIGNOR.

NOW, THEREFORE, in consideration of the sum of Ten Dollars ($10.00) and other good and valuable consideration paid by ASSIGNEE to ASSIGNOR, the sufficiency and receipt of which is hereby acknowledged, ASSIGNOR hereby transfers and assigns to ASSIGNEE the entire right, title and interest in, to and under the improvements and invention described in the United States National Phase application based on PCT/GB94/00995 filed in the U.S. Patent and Trademark Office and all continuations, divisionals, substitutes, renewals and reissues thereof; and

ASSIGNOR covenants that he has full rights to convey the entire interest herein assigned, and has not executed, and will not execute, any agreement in conflict herewith; and

ASSIGNOR further authorize the Commissioner of Patents and Trademarks of the United States, to record ownership in the U.S. national phase application based on U.S. PCT Application No. PCT/GB94/00995 as the property of ASSIGNEE; and

ASSIGNOR further covenants and agrees that he will communicate to the ASSIGNEE, its successors, legal representatives and assigns, any facts known to it respecting the improvements, and testify in any legal proceeding, sign all lawful papers, execute all divisional, continuing and reissue applications, make all rightful oaths and generally do everything possible to aid the ASSIGNEE, its successors, legal representatives and assigns, to obtain and enforce proper patent protection for the improvements.

IN WITNESS WHEREOF, ASSIGNOR has subscribed hereto, this ____ day of December, 1996.

_____
KEVAN CHARLES TAYLOR

On this _____ day of December 1996 before me came KEVAN CHARLES TAYLOR to me known and known to me to be the individual described in, and who executed the foregoing instrument, and he has acknowledged to me that he has executed the same.

_____
Notary Public

FedEx. USA Airbill

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29 1000 21348812 5350N

1 From (please print)

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Sender's Name Michael Wolfson Phone 212-790-9200

Company COWAN LIEBOWITZ LATMAN Dept./Floor/Suite/Room

Address 1133 AVE OF AMERICAS/36TH FLR

City NEW YORK State NY Zip 10036

2 Your Internal Billing Reference Information (Optional) (First 24 characters will appear on invoice) 20107.69

3 To (please print)

Recipient's Name Kevan Q. Taylor Phone ( )

Company Dept./Floor/Suite/Room

Address 501 Davis Road, #H201

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28 1000 21348812 5350N

1 From (please print)

Date 12-11-96 Sender's FedEx Account Number 0101-0074-7

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Company COWAN LIEBOWITZ LATMAN Dept/Floor/Suite/Room

Address 1133 AVE OF AMERICAS/36TH FLR

City NEW YORK State NY Zip 10036

2 Your Internal Billing Reference Information (Optional) (First 24 characters will appear on invoice) 20107.69

3 To (please print)

Recipient's Name Michael Wolfson Phone ( )

Company Cowan, Liebowitz + Latman Dept/Floor/Suite/Room

Address 1133 Avenue of The Americas
(To "HOLD" at FedEx location, print FedEx address here) (We Cannot Deliver to P.O. Boxes or P.O. Zip Codes)

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☐ FedEx Overnight Freight ☐ FedEx 2Day Freight
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5 Packaging

☑ FedEx Letter* ☐ FedEx Pak* ☐ FedEx Box ☐ FedEx Tube ☐ Other Packaging
Declared value limit $500

6 Special Handling

Does this shipment contain dangerous goods? ☐ Yes (As per attached Shipper's Declaration) ☐ Yes (Shipper's Declaration not required)

☐ Dry Ice Dry Ice, 9, UN 1845 (I) ____ x ____ kg. 904 (Dangerous Goods Shipper's Declaration not required)

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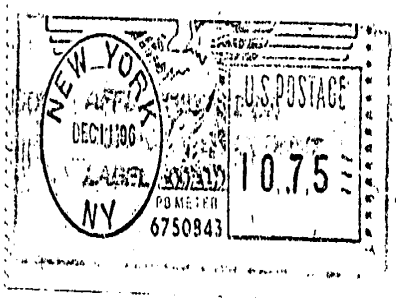

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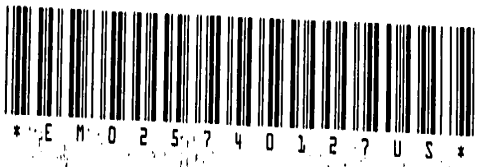

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within two months from the date of the order if made by an old proprietor and four months if made by a former licensee. These periods are, however, extensible at the Comptroller's discretion under rule 110(1), for which see para. 123.36. Since the request is to be made directly to the new proprietor, no form is specified for the request. Nor is it required that the Comptroller be notified of the request, though it may be prudent to do so, but the request would then become of public record on the file of the patent. Rule 57 is analogous to rule 9 (reprinted at para. 8.04 and discussed in para. 11.05).

Any reference to the Comptroller, either by the new proprietor or the person seeking a licence, is to be made on PF 2/77 (reprinted at para. 140.02) under rule 58 (reprinted at para. 38.03). This rule is analogous to rule 13 (reprinted at para. 11.02 and discussed in para. 11.06.

Employees' Inventions [Sections 39–43]

39.01

SECTION 39

Right to employees' inventions

39.—(1) Notwithstanding anything in any rule of law, an invention made by an employee shall, as between him and his employer, be taken to belong to his employer for the purposes of this Act and all other purposes if—

(a) it was made in the course of the normal duties of the employee or in the course of duties falling outside his normal duties, but specifically assigned to him, and the circumstances in either case were such that an invention might reasonably be expected to result from the carrying out of his duties; or

(b) the invention was made in the course of the duties of the employee and, at the time of making the invention, because of the nature of his duties and the particular responsibilities arising from the nature of his duties he had a special obligation to further the interests of the employer's undertaking.

(2) Any other invention made by an employee shall, as between him and his employer, be taken for those purposes to belong to the employee.

(3) Where by virtue of this section an invention belongs, as between him and his employer, to an employee, nothing done—

(a) by or on behalf of the employee or any person claiming under him for the purposes of pursuing an application for a patent, or

(b) by any person for the purpose of performing or working the invention,

shall be taken to infringe any copyright or design right to which, as between him and his employer, his employer is entitled in any model or document relating to the invention.

Note. Subsection (3) was inserted by Schedule 5, para. 11(1) [1988], with effect from January 7, 1991 (S.I. 1990 No. 2168).

COMMENTARY ON SECTION 39

General scope of provisions for "employees' inventions" (ss. 39–43) 39.02

Section 39 is the first of a group of sections (ss. 39–43) headed "Employees' Inventions". This group: defines a self-contained code for determining ownership of an "invention" (s. 39); regulates circumstances in which it would be "just" for an employer of such an "employee" to make payments, curiously termed "compensation", to that employee for the benefit which the employer has derived from a "patent" which has been granted for an "invention" made by the "employee" (s. 40); lays down guidelines for determining the *quantum* of such compensation (s. 41); renders unenforceable certain clauses in contracts of employment widely used before 1978 (s. 42); and limits the applicability of this group of sections to inventions made on or after June 1, 1978 and by persons "mainly employed" in the United Kingdom (including the Isle of Man). Some of the words in quotation marks in the preceding sentence are defined in section 43 (which is, in effect, a mini-interpretation section of ss. 39–42) and in section 130(1). These all receive discussion below and in the commentaries on the following sections 40–43.

The provisions of sections 39–43 were summarised, from the point of view of industrial relations, in a paper by Susan Cox ((1991) 3(1) IPB 2).

Scope of section 39 39.03

Section 39 is a provision of substantive, rather than procedural, law. It has effect in relation to the settlement of entitlement disputes under section 8, 12, 37 or 82; and to the question of "compensation" under section 40. It relates to rights in inventions made after June 1, 1978 (s. 43(1)) by persons normally resident in the United Kingdom (s. 43(2)), and has effect in relation to "patents and other protection" generally irrespective of where or how granted, see section 43(4) and para. 43.05. In all these matters it must first be decided who is the "inventor", a question on which the Act gives very little guidance, see para. 7.06 and the article by R. P. Lloyd noted therein. Section 39 then settles the question of ownership of inventions made by persons who are "employees", as between an employee and his "employer", provided that the invention was made by a person "mainly employed" in the United Kingdom (s. 43(2), as discussed in para. 43.03).

However, section 39 has no effect upon the ownership of inventions made before June 1, 1978 (s. 43(1)) and is therefore entirely inapplicable to "existing patents". The resolution of employee/employer disputes in relation to such patents continues to be determined under section 56 [1949], see paras. A056.03–A056.09. There are no provisions in the EPC, CPC or PCT relating to ownership of patent rights in inventions made by employees. These remain to be determined by individual national laws, generally (it is believed) applicable only to persons normally employed in the country in question. By the same token, section 39 relates to the ownership of patent rights anywhere in the world resulting from an invention made by a person who, at the time of making the invention (as to which, see para. 7.06), was "mainly employed" in the United Kingdom (see para. 43.03).

Section 39 also has no applicability to inventions made by non-employees. The disposition of patent rights arising from inventions made by such persons, however, remains subject to possible contractual obligations, for example in the case of research work commissioned from a non-employee. A contract between an employer and a third party concerning the disposition of patent rights of employee inventions can have no effect on patent rights which belong to an employee under subsection (1). That contract may then become incapable of fulfilment, the

consequences of which will depend upon the default provisions therein and the doctrine of frustration in the law of contract.

39.04 *Meaning of "invention" in sections 39–43*

"Invention" (as used in s. 39) is a term clearly wider than "patentable (or patented) invention", but is not defined: sections 1, 125 and 130, *inter alia*, deal only with inventions for which a patent under the Act has been applied for or granted. In *Viciball's Application* ([1988] RPC 213), it was held that "invention", as used in section 8, encompasses unpatentable subject-matter, whether because already known or because expressly excluded from the ambit of the Act (*e.g.* by ss. 1(2), 1(3) or 4(2)). For the purposes of section 39, it is immaterial whether a patent application has been filed or not. Note the phrase in the introductory part of subsection (1) "for ... all other purposes"; and the reference in section 43(4) to "other protection", particularly now that this provision had been amended specifically to relate also to section 39, see paras. 39.13 and 43.05.

This wide meaning of "invention" may well encompass many "suggestions" submitted by employees under company suggestion schemes. Care should, therefore, be taken to ensure that any rules of such schemes purporting to regulate the ownership of the submitted suggestions remain in harmony with the provisions of section 39. The effect of section 42(2) may also need to be considered, see para. 42.03, and of section 42(3), see para. 42.04. Although not a section 39 case, the nature and effect of the law of confidence in relation to suggestion schemes was examined in *Prout v. British Gas* ([1992] FSR 478).

39.05 *Meaning of "employee" for sections 39–43*

"Employee" is defined for the purposes of the Act in section 130(1) by reference to a contract of employment, a definition closely similar to that in section 153 of the Employment Protection (Consolidation) Act 1978 (c. 44), but this definition was extended by the Armed Forces Act 1981 (c. 55), by amendment of section 42(4) and 130(1) by adding the words thereto "or a person who serves (or served) in the naval, military or air forces of the Crown" (see paras. 42.01 and 130.01), thereby equating members of the armed forces to employees [of the Crown] for the purposes of sections 39–43.

Also, the 1988 Act defines "employee", though for the purposes of copyright and design law only, as referring to employment "under a contract of service or of apprenticeship" (ss. 176 and 263(1) [1988]), thereby raising a doubt as to the position of apprentices in relation to the ownership of inventions made by them.

39.06 *The status of the inventor as employee*

In most cases, the status of the inventor as employee is not in doubt, but difficult problems can arise with regard to directors (*Parsons v. Parsons*, [1979] FSR 254), who are not necessarily employees (*Parr's Patents*, SRIS O/46/94) and also with consultants, and the increasing number of "home workers". In such cases one must first determine if there is a contract at all, and then, if so, whether the contract is one "of service" or "for services". The question is one of law rather than fact (*Davies v. Presbyterian Church of Wales*, [1986] 1 WLR 323; [1986] IRLR 194 (HL)). An equity-holding partner in a firm is an employer of its staff and cannot therefore be said to be employed by it himself, but the ownership of shares in a company, even by a majority shareholder, is irrelevant as the company is an equity quite separate from its members (*Salomon v. Salomon & Co. Ltd*, [1897] AC 22 (HL)).

Given the crucial difference in treatment of employees for tax and national insurance purposes, as well as for entitlement to social security benefits and employment protection rights (*e.g.* as regards redundancy, unfair dismissal, health and safety provisions, protection of pay when the employer becomes insolvent, etc.), a huge body of case law on the point has built up in employment law. To summarise it here is beyond the scope of this commentary, but in one of the leading cases (*O'Kelly v. Trusthouse Forte*, [1984] QB 90; [1983] 3 All ER 456 (CA)) it was said that, in order to determine employee status, all aspects of the relationship must be considered and no single factor is in itself decisive. One such factor is the label the parties themselves put on the relationship (*Narich Property v. Comm. of Pay-Roll Tax*, [1984] ICR 285 (PC), following *Massey v. Crown Life Insurance*, [1978] 1 WLR 676; [1978] 2 All ER 576 (CA)). No single test is adequate in all circumstances, *e.g.* not the older "control" or master-and-servant test, but currently courts favour the so-called "economic reality" (or "mixed") test, see *Lee Ting Sang v. Chung Chi-Keung* ([1990] 2 AC 374 (PC)), although that case involved compensation for employee injury where the plaintiff wished to be considered as an employee, whereas the opposite may be true in a case under section 39. The question in its simplest form is whether the person doing the work is in business on his own account or not; and whether there are mutual obligations between the alleged employer and alleged employee.

Cases in which it was held that that a creator was not an employee at the relevant time are: *Coffey's Registered Designs* ([1982] FSR 227), where the designer was at the time only a partner in an informal partnership under no trust obligation thereto or to a company incorporated only subsequently, and *Gleave's Patent* (SRIS O/22/88), where a referrer (in s. 37 proceedings) failed to prove that the patent proprietor was an employee at the relevant time and where it appeared that the alleged employer company had not then been incorporated. In *Stablocel's Applications* (SRIS O/3/91, *noted* IPD 14101), the referrer in entitlement proceedings failed to prove that he had made the invention during a short period when he was unemployed following redundancy from, and liquidation of, his former employer and his re-engagement by the successor thereto.

Where an employee is *seconded* by the employer to a third party then, in the absence of a contrary agreement, his/her inventions will in the circumstances described in subsection (1) belong to the employer and not to the third party, although of course the employer is free to assign all rights in the invention to that third party (*Defence Technology's Application*, SRIS O/17/93, *noted* IPD 16124).

Ownership of employee inventions by an employer

—The basic rule 39.07

The introductory phrase of subsection (1) simply sweeps away any rule evolved under the common law before June 1, 1978 (*Harris's Patent* [1985] RPC 19). This renders precedents decided under the common law of no assistance for subsection (1)(a) cases and of only limited help in subsection (1)(b) cases. The factual situation can be proved under subsection (1)(a) either by reference to the employee's "normal duties" or to other duties "specifically assigned to him", whereas subsection (1)(b) provides a third gateway through which an employer can claim rights, by reference to the employee's "particular responsibilities" and an ensuing "special obligation", though still provided that the invention was made within the scope of the duties of that employee.

Although the question of onus of proof under section 39 is not free from doubt, the better view is that an employee will own his invention by virtue of subsection (2) *unless* his employer can prove that the situation under either part of subsection

(1)(a) or under subsection (1)(b) exists in fact. However, in entitlement proceedings under section 8, 12, 37 or 82, the Comptroller holds the view that the referrer has the onus of proving its contentions. This view, based on section 7(4), *i.e.* when a patent application has already been filed, is open to the criticism that it overlooks the effect of section 39(2). It is submitted that the better view, supported by *Harris's Patent* (*supra*), is that, when section 39 is under consideration, the onus should be on the employer to show that the facts correspond to one of the situations in section 39(1) irrespective of whether it was the employer or the employee who was the applicant of the disputed application.

For each of the three gateways of subsection (1) a two-stage inquiry is required, the first stage being broadly common to each of these, *viz.* the establishment of the actual duties of the employee. The second stage is then: (in both parts of subs. (1)(a)) consideration of the circumstances in which the invention was made; and (in subs. (1)(b)) consideration of the particular responsibilities and obligations of the employee. As *Harris* (*supra*) shows, the Comptroller or court will not be satisfied with job titles but will "lift the veil" to establish the detailed facts.

These facts will often show that a person, though an employee, engages in a number of activities at different times. Not all those activities may be "duties" of employment at all. For example, the position of university lecturers is particularly obscure in relation to their research activities if they are engaged primarily to teach, with spare time allowed for research, but no obligation to carry it out. The position of such persons was discussed by W. R. Cornish in "Rights in university innovations: The Herchel Smith lecture for 1991" ([1992] EIPR 13).

Subsections (1) and (2) are mutually exclusive as between employer and employee. It is submitted that this overrides the Comptroller's discretionary powers under sections 8 and 37 to grant a patent to joint proprietors where these would be employer and employee and confirms the position under the 1949 Act, as decided in *Patchett v. Sterling* ((1955) 72 RPC 50 (HL)). However, in *Szucs' Application* (SRIS O/27/88, *noted* IPD 11014) (decided under s. 37), ownership was awarded to the employee, but with a free licence under the patent to the employer. The Comptroller stated that joint proprietorship was unattractive, but did not suggest (as it seems he should have) that the law precluded this.

In *Peart's Patent* (SRIS O/209/87) the Comptroller did not accept an argument that conception of an invention outside working hours fell outside the scope of an employee's duties, while accepting that the invention was not made in the course of the referrer's normal or specifically assigned duties for the purposes of subsection (1)(a). The decision can be criticised because, for the purposes of subsection (1)(b), it must first be shown that the invention was made in the course of the duties of the employee, before proceeding to focus on the "special obligations", *i.e.* more than the general duty of fidelity.

The Comptroller has been prepared to hold (in an uncontested case) that all rights in an invention belong to the employer when the inventor had apparently been employed to carry out duties relating to the invention (*Travenol Laboratories' Application*, SRIS O/45/90, *noted* IPD 13141); but in *Hamill's Application* (SRIS O/149/92), he was careful to find that the invention had been made in the course of the normal duties of the employee and was the type of invention which could be expected to result from the carrying out of those duties. In *Defence Technology's Application* (SRIS O/77/93, *noted* IPD 16124), the referrer failed to prove his invention was not made in those circumstances. In an interlocutory application in a copyright case, it was held not to be unarguable that "moonlighting" falls within the phrase "in the course of employment" (*Missing Link Software v. Magee* [1989] FSR 361). Decisions given by the Comptroller on entitlement and inventorship disputes prior to 1990 were reviewed by T. Z. Gold ([1990] EIPR 382).

—The employee's normal duties 39.08

In *Harris's Patent* ([1985] RPC 19), the "normal duties" of an employee were defined as the actual duties which he was employed to do. Thus, an employee's "normal duties" will be those defined by his contract of employment, including additional terms which may be implied, *e.g.* the duty of good faith and terms which are incorporated from collective agreements between employers and trade unions, from custom and practice, and from ancillary documents such as pre-employment correspondence, engagement letters, handbooks, works rules, notices on notice boards, etc. In *Harris* (*supra*), it was held never to have been part of the duties of the employee to turn his mind to solving technical problems.

Harris also settled the controversy over the scope of the implied term of an employee's duty of good faith, sometimes referred to as the duty of fidelity: it is co-extensive with, and does not go beyond, contractual duties. In this, *Harris* followed *United Sterling v. Felton and Mannion* ([1974] RPC 162) in which it was stated that the duty of fidelity expires at the moment the contract of employment terminates, though there is a continuing obligation not to disclose the employer's confidential information (*Faccenda Chicken v. Fowler*, [1986] FSR 291 (CA)). It should be noted, however, that contractual duties beyond that of fidelity may be implied (*Attorney-General v. Guardian Newspapers (No. 2)*, ([1989] 2 FSR 181; [1988] 3 All ER 545, the *"Spycatcher"* case).

In *Secretary of State for Defence's Application* (SRIS O/135/89, *noted* IPD 13063), the Comptroller saw no distinction between "official" and "normal" duties, and, where research workers had investigated whether a particular topic should become an approved research product, this was regarded as part of their normal duties. In *British Gas's Application* (SRIS O/176/92), the employed inventor was unsuccessful in his claim to ownership. Some years after he had left his employer's service division and while working on his own initiative, though with the knowledge of the employer and using the employer's materials, the invention was made. The inventor reported this and suggested the filing of a patent application. In these circumstances the invention was held to have been made during the course of the inventor's normal duties. Likewise, in *Greater Glasgow Health Board's Application* (SRIS O/136/94), the inventor was employed as a clinical hospital registrar and research facilities were made available to him. It was held that his normal duties included trying to improve patient treatment and that this included considering the modification of an existing ophthalmic instrument.

—Duties specifically assigned to employee 39.09

In *Secretary of State for Defence's Application* (SRIS O/135/89, *noted* IPD 13063), specifically assigned duties were stated to be duties which are not the standard or everyday duties for which a person is normally employed. Given that it is an implied term of a contract of employment that an employee must obey lawful orders, and that an order to carry out duties outside the contract is a breach of that contract and is thus unlawful (unless an employee agrees and there is some consideration to support the consensual variation), an employee who carries out specifically assigned duties under protest and reserving his position may not be caught by subsection (1)(b); and see para. 39.12. For a discussion of an employee's duties falling outside of his normal duties, but specifically assigned to him, see the article by B. Bercusson ([1980] EIPR 257).

—Performance of normal or specifically assigned duties 39.10

The second stage of inquiry under subsection (1)(a) is concerned with whether the performance of the duties, as established in the first stage, is expected to result

in an invention. *Harris's Patent* ([1985] RPC 19) settled that the words "an invention" have a narrower meaning than "any invention", but are wider in scope than "the invention the subject of the dispute". But it is still unclear whose expectations are decisive, the employer's or the employee's, and whether the time of the expectation is the date of commencement of the duties in question or the date when the invention is made.

It is arguable that subsection (1)(a) achieves the same result as had been reached by 1977 under the common law, albeit by a different route. Thus, in *Electrolux v. Hudson* ([1977] FSR 312), a clause in a contract of employment under which the employer claimed ownership of an employee's invention was declared void as being wider than required to protect the employer's legitimate interest and therefore against public policy and in restraint of trade, in effect for not being confined to inventions flowing naturally from the performance of the employee's duties. On this basis former precedents may still have some persuasive value.

39.11 —*Employees with special obligations*

Subsection (1)(b) provides the third gateway whereby an employer can establish ownership of an invention made by an employee. The invention must still be one made "in the course of the duties of the employee". Then, in addition, the employee must be one who, at the relevant time, had a special obligation to the employer, arising from the nature of his duties and responsibilities, to further the interest of the employer's undertaking. The omission of "normal" in the reference to "duties" is no doubt deliberate and in contrast to subsection (1)(a). Subsection (1)(b) clearly covers employees in senior management whose duties are not so closely definable as to make "normal" meaningful in relation thereto. Thus, in *Peart's Patent* (SRIS O/209/87), a works manager was held not to have discharged the onus on him to show that he did not have an obligation which extended to an invention he made at a time when he had been instructed not to involve himself in research and development matters. However, just how far down in the hierarchy of a given organisation one can go before an employee will cease to be covered by subsection (1)(b), irrespective of his inventions being covered by subsection (1)(a), will always be a difficult question.

In *Defence Technology's Application* (SRIS O/77/93, *noted* IPD 16124), a high-grade employee was seconded to a key position in the organisation of a third party and made an invention, the ownership of which he disputed. There were no written provisions as to ownership of inventions by the employer, the employee or the third party. It was held that the employee owed a special obligation to further his employer's interests and that, on the balance of probabilities, the employer would have assigned the rights under the invention to the third party. The fact that, shortly after making the invention, the employee became employed by the third party without any real change in his job duties but under a contract which did deal with ownership of inventions, supported the finding that the invention made during the secondment should also belong to the third party.

In *Rutter and Pape's Applications* (SRIS O/143/94), the applicants had been joint managing directors of a company. Although the normal duties of each of them did not include the making of inventions, their executive position was such that their invention rights were owned by that company. A less clear case of an inventor having a special obligation to further the interests of his employer because of his seniority and executive responsibilities is *Staeng's Patent* (SRIS O/131/94).

39.12 —*Employee holding invention on constructive trust for employer*

Where it is established that the employee is entitled to the benefit of an invention held on trust for him by the employer, the common law of constructive trusts will

come into force, as discussed in the book by J. Phillips and M. J. Hoolahan, "*Employees' Inventions in the United Kingdom*" (ESC Publishing Ltd., 1982). In such a trust the employee not only takes the benefit, but also the liabilities, of the resulting trusts (*Triplex v. Scorah*, (1938) 55 RPC 21). The employee is then entitled to compensation for any expenditure he may have incurred in developing and protecting the invention, as was required in *Hindmarch and Homer's Application* (SRIS O/158/80, *noted* IPD 3147). In the case where an employer solicits the aid and services of an employee beyond the scope of his normal duties without any "consideration" or promise of remuneration subsequent to his performance of the requested services, the employee may have a quasi-contractual remedy of *quantum meruit* to recover the value of those services from the employer.

Application of section 39 to particular cases 39.13

The application of the principles set out in section 39(1) to particular facts usually arises in proceedings under section 8, 12, 37 or 82 (determination of entitlement to patent ownership). Decisions on these are therefore discussed mainly in the commentary on section 37 at para. 37.12, but see also para. 8.10. The applicability of section 39 to members of the academic staff of a university has been discussed by W. R. Cornish, see para. 39.07, along with the rather different rule for ownership of copyrights created by an employee.

Decisions under the common law 39.14

Precedents decided under common law principles should be treated with considerable caution, see para. 39.07. This is partly due to the inconsistency of pre-1978 cases such as *British Syphon v. Homewood* ([1956] RPC 225 and 330) and *Selz's Application* ((1954) 71 RPC 158 (PAT)); and partly because these cases were generally concerned to determine, as a first step, whether the invention was made "in the course of employment", for example as in *Hindmarch and Homer's Application* (SRIS O/158/80, *noted* IPD 3147, decided under s. 56 [1949]). It is submitted that the phrase "duties of an employee" in section 39(1) has a narrower meaning. Whether an act was "in the course of employment" has been the subject of numerous labour law cases involving, *e.g.* employers' vicarious liability for their employees' acts, and is closely bound up with the concept of authorisation, express or implied, for a given act.

Determination of inventor ownership disputes 39.15

An inventorship dispute can arise under section 13 (mention of inventor) or under section 8, 12, 37 or 82 (determination of question of entitlement). Employee-employer ownership disputes on "existing patents" are resolved under section 56 [1949]. The procedure for resolving such disputes is discussed in the commentaries on these sections.

Settlement of disputes by employers 39.16

Employers will naturally seek to settle inventorship disputes with, or between, their employees by informal and internal procedures. If this is to be done, it is important that the procedures used by the employer should be fair, not too lengthy, and generally comply with rules of natural justice.

There is an overriding implied term in a contract of employment that employers will not, without reasonable and proper cause, conduct themselves in a manner

calculated or likely to destroy or seriously damage the implied (or express) obligation of trust and confidence between employer and employee, see *United Bank Limited v. Akhtar* ([1989] IRLR 507 (EAT)). The application of this implied term can prohibit actions which would on the face of the contract be legitimate for the employer, and in so far as an express contractual term gives an employer a discretion, it should not be exercised in a capricious way, see *White v. Reflecting Roadstuds Limited* ([1991] IRLR 331 (EAT)).

In an interlocutory case, *Newns v. British Airways* ([1992] IRLR 575), the Court of Appeal stated that there was an implied contractual duty of "good faith" on the employer, requiring fair dealing with employees, and a breach of this duty could be restrained by an injunction. It may therefore be argued that the implied term enunciated in *Akhtar, supra* (and possibly the implied duty found in *Newns*) is a fundamental term in the contract of employment a breach of which entitles an employee (with a qualifying period of service, currently of two years) to resign and claim compensation for unfair constructive dismissal under section 57(1)(c) of the Employment Protection (Consolidation) Act 1978 (c. 44), see in general *Western Excavating v. Sharp* ([1978] QB 761; [1978] 1 All ER 713 (CA)).

39.17 *Contrast with employer ownership of copyrights and design rights created during employment*

Sections 11(2) and 215(3) [1988] have effect respectively to pass first ownership of copyrights and design rights created by an employee "in the course of his employment" automatically to the employer, subject in the latter case only to the prior right of one who commissioned the making of the design. A topography right is treated in the same way as a design right, except that here the statutory provision may be varied by a written agreement (Design Right (Semiconductor Topographies) Regulations 1989, S.I. No. 1100, rr. 2, 5).

First ownership of registered designs is also now governed as for a design right (Registered Designs Act 1949 (c. 88), s. 2(1B) as inserted by s. 267 [1988] and as reprinted in Sched. 4, para. 2(1B) [1988]). If, as seems to be clearly the case, this phrase is wider in scope than the combined effect of the three gateways of section 39(1), then decisions in relation to these other types of intellectual property rights will have no direct effect on the interpretation of section 39.

Conversely, having regard to the lack of definition of "invention" in section 39 and the presence in the introductory passage of subsection (1) of the phrase "for the purposes of this Act *and all other purposes*" (emphasis added), it may be that section 39 has the unexpected effect of modifying the ownership regimes in the above-mentioned Acts and Regulations if the design or copyright work can be said to be an "invention"; and this may be a clue to the interpretation of "other protection" in section 43(4), see para. 43.05.

Aside from the argument whether a design or copyright work is nevertheless also an "invention", a dichotomy between employees' rights in different species of intellectual property will often arise from the same, or closely associated, acts leading to a position where, even though an employee may own patent rights because the employer is unable to establish any of the criteria of subsection (1), nevertheless the employer may own associated copyrights, design rights, registered designs, etc., because these have been created by the same employee "in the course of his employment".

39.18 *Employees' immunity under associated copyrights and design rights (subs. (3))*

To alleviate the position set out in para. 39.17, subsection (3) was added, and an amendment made to section 43(4), by the 1988 Act (Sched. 5, para. 11). Under new

subsection (3), where by virtue of subsection (2) an invention belongs to an employee, rather than to the employer, then nothing done by or on behalf of the employee, or his successor in title, for the purpose of prosecuting an application for a patent, or by any person for the purpose of performing or working the invention, "shall be taken to infringe any copyright or design right" in "any model or document" to which the employer is entitled, rather than the employee. It seems slightly odd that subsection (3) does not include a reference to registered designs, but a possible explanation is that the legislator could not conceive of a registrable design as an "invention", given the exclusions from registrability in section 1 of the Registered Designs Act 1949, as amended by the 1988 Act.

Thus, employers will not be able to use these other intellectual property rights to prevent employees from obtaining patents on their own inventions. Also, new subsection (3)(b) is presumably intended to provide a defence in any action for infringement of any copyright or design right arising from a model or document to which the employer is entitled. However, this provision may not be as wide as it seems at first sight. It is clearly intended to apply to copyrights of which the employee in question is the author (designer) but, as regards documents or models created by the employee's colleagues, the resulting copyright or design right may not perhaps be a right "between him [the employee] and the employer".

The amendment to section 43(4) has the effect that any reference to "patent" in section 39 extends to a "patent or other protection" granted, whether under the law of the United Kingdom or otherwise. This provision is discussed further in para. 43.05. However, in its application to section 39(3) (the word "patent" not appearing otherwise in s. 39), it is difficult to see how United Kingdom law can effectively provide a defence to an action brought in another country for infringement of an intellectual property right in that country unless perhaps a United Kingdom court would grant an injunction against the employer entity to prevent it from seeking to assert its foreign "protection" contrary to section 39(3)(b), as extended by section 43(4). Also, because copyrights (and design rights) are not "granted", the provision may be ineffective anyway, see para. 43.05.

PRACTICE UNDER SECTION 39

Keeping of records 39.19

Whether section 39(1) applies to an invention made by an employee depends on the circumstances in which an invention was made. In the interest of both employer and employee, it is most desirable to set out in writing the employee's normal duties, whether the employee has any special duties or obligations, to record any change in the employee's normal duties and when any other duties are specifically assigned thereto with the employee's consent, as well as the consideration therefor.

It must be a question of fact whether an employee might reasonably be expected to make inventions in carrying out his/her normal, or assigned and accepted, duties. An attempt can be made to deal with this point in the contract of service, but in cases of doubt past experience of the employer as to whether a particular class of employee (e.g. a sales engineer) has made, or been expected to make, inventions as a result of carrying out the employee's normal duties might be relevant in determining ownership of the invention.

In the interests of certainty it may be desirable, before a patent application is filed, that an employee-inventor be asked to sign a declaration as to the ownership of the invention. In any event, personnel records of inventors should be maintained for at least one year after the patent has ceased to have effect, see rule 59(2) reprinted at para. 40.02. An attempt may be made to claim inventorship many years after the application was filed, see para. 13.10. Papers by K. Hodkinson in *The*

 #c/

Attorney Docket No. ITI-169

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	KEVAN C. TAYLOR
Serial No.:	08/604,975
Filed:	March 25, 1996
International Application No.:	PCT/GB94/00995
International Filing Date:	9 May 1994
For:	LINING OF PIPELINES OR PASSAGEWAYS

DECLARATION OF JOHN W. HEAVENS IN SUPPORT OF PETITION PURSUANT TO 37 C.F.R. § 1.47(B)

Box PCT
Assistant Commissioner of Patents
Washington, D.C. 20231

S I R:

I, JOHN W. HEAVENS, hereby declares as follows:

1. I am the Product Manager, Potable Water for Insituform Technologies, Inc. ("ITI"), the ultimate corporate parent of INA Acquisition Corp., Insituform Licensees B.V./S.A. and Insituform (Netherlands) B.V., the applicants of the underlying PCT application No. PCT/GB94/00995. Insituform (Netherlands) B.V. is the owner of Intellectual property rights for the Insituform® Process of pipeline rehabilitation for North America and owns this United States application.

2. I have been continuously employed by Insituform or one of its Insituform subsidiaries since November, 1990. Prior to

my appointment as Product Manager, Potable Water for ITI, I was General Manager, Special Operations and General Manager, Laterals Programs for Insituform Technical Services, Limited, one of the Insituform companies in the United Kingdom. At the end of 1991, I was placed in charge of the Laterals Program for Insituform. At that time, Mr. Kevan C. Taylor was employed by Insituform Technical Services Limited as Development Project Leader to lead development of the Insituform laterals program.

3. Mr. Taylor first became an employee of Insituform Technical Services Limited on 4 December 1989 under the terms set forth in a letter dated 30 November 1989 from Dr. Downey, the then Managing Director of Insituform Technical Services Limited. A copy of the 30 November 1989 letter is unavailable in the Insituform records, but a letter of 4 December 1989 from Mr. Taylor accepting the employment offer of 30 November 1989 is annexed hereto as Exhibit A.

4. At the time of his appointment to the Laterals Program in the Fall 1991, Mr. Taylor was Development Project Leader as reflected in a 15 October 1990 letter agreement between Mr. Taylor and Dr. J. E. Gumbel, Managing Director of Insituform Technical Services Limited effective 1 March 1990. A copy of the 15 October 1990 letter agreement is annexed as Exhibit B.

5. During the period from the Spring of 1992 through the Spring of 1993, I was responsible for the lateral installation program on the Isle of Mann and Mr. Taylor reported to me during that period of time. I am familiar with the subject matter of PCT

application No. PCT/GB94/00995. Based on my personal knowledge, the subject matter of the application was completed by the Spring, 1993 at the conclusion of the laterals project on the Isle of Mann.

6. Based on my understanding of employment law in the United Kingdom, as set forth more fully in the accompanying Declaration of Andrew M. Donlan, the Patents Act 1977 provides that inventions made by an employee in the United Kingdom shall belong to the employer if it was made in the course of (a) the normal duties of the employee, or (b) duties of the employee were of such nature that they gave rise to particular responsibilities so that the employee had a special obligation to further the interest of the employer's undertaking. In my view, Mr. Taylor who had been appointed to mastermind the development of an Insituform laterals program, was so employed as set forth in the Patents Act 1977. His employment activity relating to the subject matter of this application all took place in the United Kingdom.

7. It is my understanding that Mr. Taylor completed the invention set forth in application No. PCT/GB94/00995 well within his term of employment by Insituform in the United Kingdom. Subsequent to that time, Mr. Taylor became employed by ITI, a copy of which Employment Agreement is annexed to the Declaration of William A. Martin dated March 20, 1996 and filed in support of the original Petition.

8. Prior to filing British priority Application No. 9319832.3 on 25 September 1993, Mr. Taylor forwarded to Mr. James Denmark of Bailey Walsh & Co., the British and European patent agents for

Insituform in the United Kingdom at that time, completed sketches of the invention described and claimed in the PCT application. A copy of the facsimile transmission of these drawings to Mr. Denmark bearing a transmission date prior to filing of the British application is annexed hereto as Exhibit C.

9. The invention described and claimed in U.S. application No. 08/604,975 based on PCT/GB94/00995 is owned by Insituform (Netherlands) B.V. by virtue of Mr. Taylor's employment with Insituform Technical Services Limited. These facts are established from the business records of Insituform Technical Services Limited and the fact that Mr. Taylor was under an obligation to assign this invention to the appropriate Insituform subsidiary. Accordingly, on behalf of ITI and Insituform (Netherlands) B.V., I request acceptance of this application based on the accompanying Petition and that Insituform be permitted to prosecute the application on the merits on behalf of and as agent to Kevan C. Taylor, the inventor.

10. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United

States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

JOHN W. HEAVENS

Dated: December 11th, 1996
Memphis, Tennessee

33 Boughton Avenue
St Johns
Worcester
WR2 5EH

4 December 1989

Dear Dr Downey

I accept the terms and conditions set out in your letter of offer of employment dated 30 November 1989. I also agree to the conditions of the confidentiality returned herewith and duly signed.

Yours sincerely

K Taylor

Kevan Taylor

enc

Exhibit B

INSITUFORM®
TECHNICAL SERVICES LIMITED

10 Harrowden Road Brackmills, Northampton NN4 0EB
Telephone: (0604) 700707 Facsimile: (0604) 760762

PRIVATE AND CONFIDENTIAL

Mr Kevan Taylor
33 Boughton Avenue
St Johns
Worcester
WR2 2EH

15 October 1990

Dear Kevan

I am pleased to confirm your appointment, effective 1 March 1990, as Development Project Leader reporting to the Manager, Engineering Group.

The terms of this offer are as follows:

1. Annual Salary

The annual salary for this appointment is £19,200 payable monthly in arrears in equal monthly instalments net of tax and other deductions required by law which the Company shall be entitled to withhold.

2. Company Car

A company car is allocated to this position, and you are entitled to continue to use the company car already in your charge. The car will be fully maintained by the Company including maintenance, insurance and petrol; all in accordance with the Company Car Policy.

3. Pensions

You are entitled, subject to eligibility, to participate in the Company's Grouped Personal Pension Plan, details of which are available on request. The Company will contribute an additional 5% of your Annual Salary for direct payment to the Scheme.

4. Life and Disability Insurance

Subject to acceptance by the insurers you will receive life cover equivalent to four times your Annual Salary, together with travel, accident and disability insurance at such rate as the Company may consider appropriate from time to time.

5. Medical Insurance

The Company will pay, for the benefit of you and your dependant spouse and children (under the age of 19 and as defined in the Plan) subscription to PPP or other comparable scheme).

6. Working Hours

Your normal working hours will be 9.00am to 5.30pm Monday to Friday, with up to one hour's lunch break per day (ie 37.5 hours per week).

7. Holidays

The Company's holiday year is based on the calendar year, and your annual entitlement is 20 working days. Entitlement during the year of joining or leaving will be on a proportionate basis. Holidays will not be paid in lieu, but any leave entitlement outstanding at 31 December may be carried forward to not later than 5 May in the following year.

8. Place of Work

Initially, your place of work will be Northampton and you shall reside within a reasonable daily commuting distance of Northampton. You will also perform your work in such other places as the Company may require from time to time.

9. Travel

The performance of your duties will require business travel. The Company will reimburse you for all authorised and reasonable travelling and other out-of-pocket expenses actually and properly incurred in connection with your duties and pursuant to the Company's Travel Policy.

10. Sickness

The Company will pay for 10 sick days in the aggregate during the calendar year. Additional sick days up to 20 will be paid at half salary. For long term illness of a continuous nature, the Company will pay as follows:

In the first year of employment:

Full salary up to 1 month;
Half salary for the next 5 months.

For the next two years:

Full salary up to 3 months;
Half salary for the next 3 months.

From the fourth year on:

Full salary up to 6 months.

11. Notice Period

If you decide to leave the employment of the Company, you are required to give one months written notice of your intentions. Should the Company decide to terminate your employment (except on grounds of gross misconduct, where the statutory minimums will apply) it will likewise provide you with one months notice.

12. Medical

This appointment is subject to a satisfactory medical at Company expense and with a doctor appointed by the Company.

Please confirm your acceptance of the above terms by signing and returning to me both the attached copy of this letter, and one copy of the enclosed Confidentiality Agreement which reflects the change of your employment status from temporary to permanent with effect from 1 March 1990.

Yours sincerely

JE Gumbel

Dr J E Gumbel
Managing Director

Accepted by

Signature ..K Taylor.....

Date ..22/10/90.....

Exhibit C

INSITUFORM PERMALINE LTD

Insituform Permalline Limited
Roundwood Industrial Estate
Ossett, West Yorkshire WF5 9SQ.
(Registered Office)

Tel: Wakefield (0924) 277076
Fax: Wakefield (0924) 265107
Telex: 556277

Your Ref

Our Ref

FACSIMILE

IF NOT RECEIVED COMPLETE PLEASE TELEPHONE THE ORIGINATOR AT THE ABOVE NUMBER

TO: Bailey Walsh & Co

FOR THE ATTENTION OF: Jim Denmark

FROM: Kevan Taylor YOUR REF:

TRANSMISSION DATE: TIME:

FAX NO: 0532 - 445699

NUMBER OF PAGES: (including this sheet) 3

Jim,

These are my sketches for the Shortee Repair System as requested. Please call me if you require further info - At Permaline Contact Jackie who will know where I am or Home at 0933-31.788

Best regards

Kevan.

Best Available Copy

6858

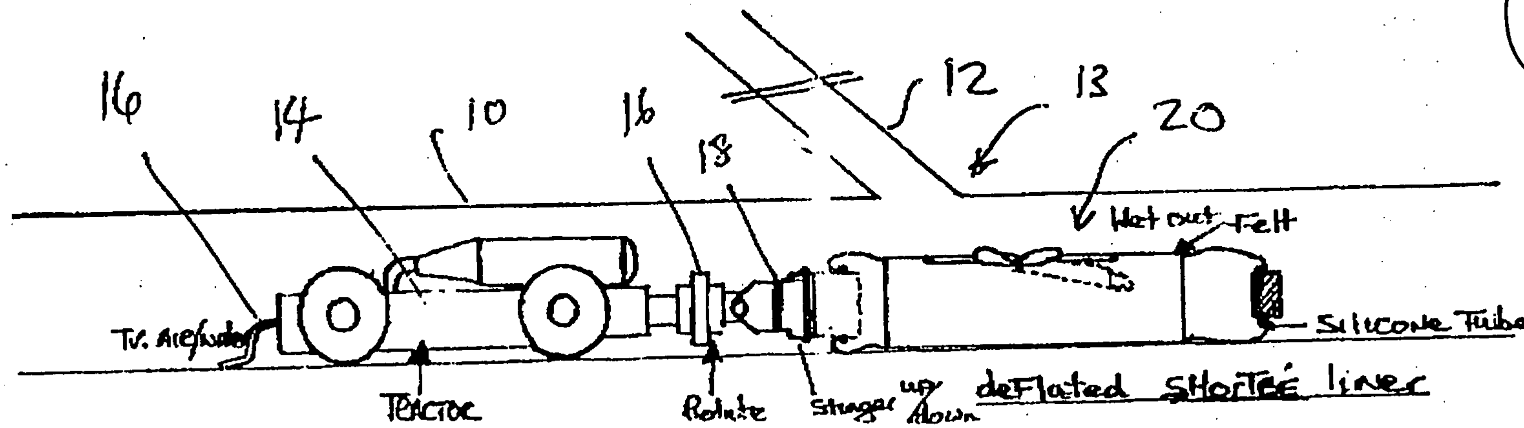


FIG. 1

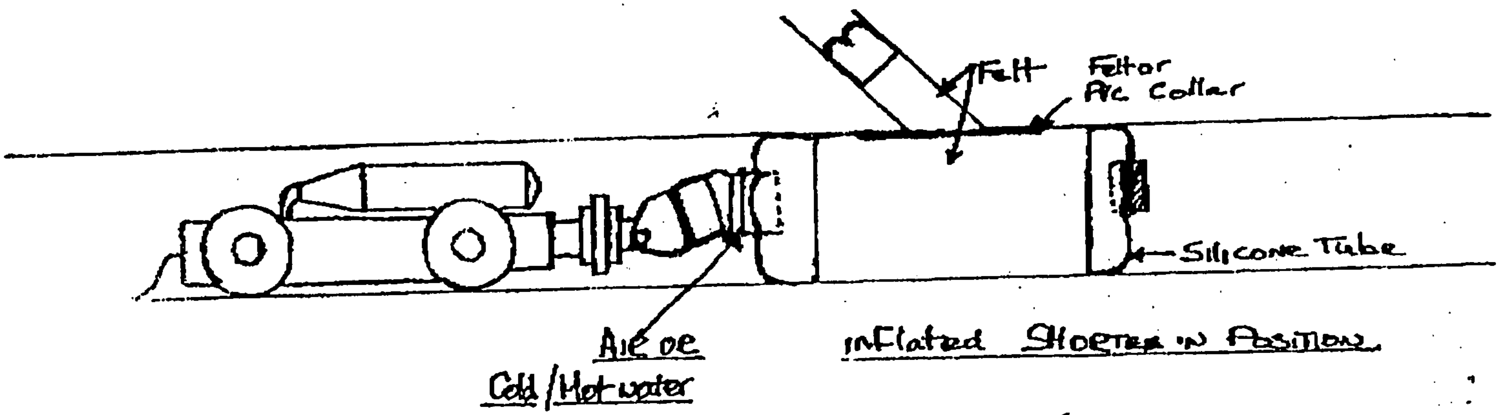


FIG. 2

SHORTEE' Repair.

Shortliner/lateral in one operation

plans to do [illegible]

Has failed repair - with lateral

silicone undersized - can be pulled out

flow through host between collars

Inv. [illegible]

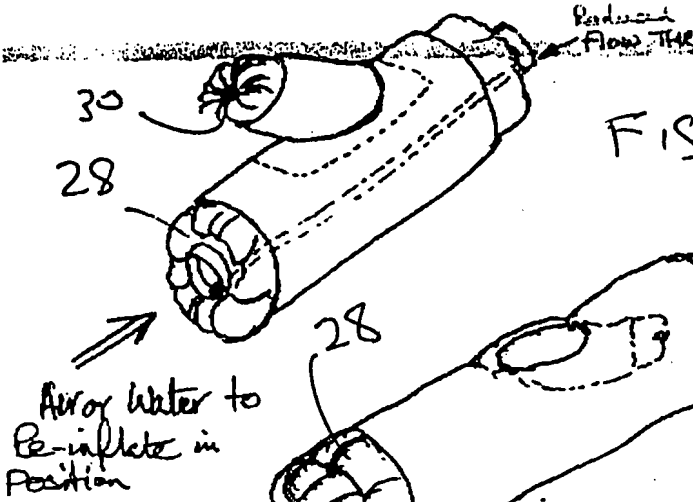
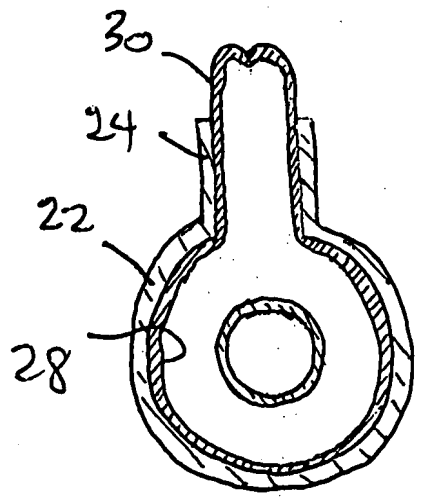


FIG.5

FIG.6

FIG.7



SHORTEE' Repair System without Re-opening Connection

longitudinal seal - entrance

center seal

K Baylor / Ericwood.

#4

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	KEVAN C. TAYLOR
Serial No.:	08/604,975
Filed:	March 25, 1996
International Application No.:	PCT/GB94/00995
International Filing Date:	9 May 1994
For:	LINING OF PIPELINES OR PASSAGEWAYS

DECLARATION OF RAYMOND P. TOTH
IN SUPPORT OF RENEWED PETITION UNDER 35 C.F.R. § 1.147(b)

Assistant Commissioner for Patents
Box PCT
Washington, D.C. 20231

Attention: PCT Legal Office

S I R:

RAYMOND P. TOTH, hereby declares as follows:

1. I am Vice President - Human Resources for Insituform Technologies, Inc. ("ITI"), located at 1770 Kirby Parkway, Suite 300, Memphis, Tennessee 38138. ITI is the ultimate corporate parent of all Insituform companies, including Insituform (Netherlands) B.V., the 37 C.F.R. §1.47(b) applicant herein. I make this Declaration in support of the Renewed Petition to accept this application pursuant to 37 C.F.R. §1.47(b).

2. I have reviewed the corporate records at ITI and can confirm that Mr. Kevan C. Taylor was employed by ITI at Memphis from 22 April 1994 to 25 January 1995 and that his last known address at that time is 3226 Knight Lane, Apt. No. 258, Memphis, TN 38115.

3. In April of 1995, following the termination of Mr. Taylor's employment with ITI, ITI contacted the United States Postal Service to obtain a forwarding address for Mr. Taylor so that an expense reimbursement could be sent to him. The Postal Service refused to provide this information and we sent the expense reimbursement to Mr. Taylor in care of his Knight Lane address. We can confirm that this was forward to Mr. Taylor as the check was cashed on May 26, 1995.

4. During the preparation of this Declaration today 11 December 1996, I discovered that on 17 October 1996, ITI received a request to verify the employment of Kevan C. Taylor in connection with a home mortgage loan application. The request identified Mr. Taylor's address as 501 Davis Road # H 201, League City, TX 77573. I am not in a position to confirm whether this was or is his address since the ITI business records reflect the Knight Lane address set forth in Paragraph 2, above.

5. As soon as this information was discovered today, it was provided to ITI patent counsel who advised that a further request for Mr. Taylor to sign the application papers is being forwarded to Mr. Taylor by Express Mail and Federal Express today.

6. Based on these facts from the business records of ITI, I can confirm that the communications forwarded to Mr. Taylor at his Knight Lane address on February 9, 1996, August 23, 1996 and October 4, 1996 were sent to his last known address at that time. Thus, Mr. Taylor could not be found or reached after diligent effort. Accordingly, on behalf of ITI and its subsidiaries,

this application should be accepted for prosecution under 37 C.F.R. §1.47(b) and that Insituform should be allowed to prosecute the application fully on the merits on behalf of and as agent for the inventor in order to preserve the rights of Insituform and prevent irreparable damage.

7. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Raymond P. Toth

RAYMOND P. TOTH

Date: December 11, 1996

Exhibit A

FannieMae

Request for Verification of Employment

COPY

Privacy Act Notice: This information is to be used by the agency collecting it or its assignees in determining whether you qualify as a prospective mortgagor under its program. It will not be disclosed outside the agency except as required and permitted by law. You do not have to provide this information, but if you do not your application for approval as a prospective mortgagor or borrower may be delayed or rejected. The information requested in this form is authorized by Title 38, USC, Chapter 37 (if VA); by 12 USC, Section 1701 et. seq. (if HUD/FHA); by 42 USC, Section 1452b (if HUD/CPD); and Title 42 USC, 1471 et. seq., or 7 USC, 1921 et. seq. (if USDA/FmHA).

Instructions: Lender — Complete items 1 through 7. Have applicant complete item 8. Forward directly to employer named in item 1.
Employer — Please complete either Part II or Part III as applicable. Complete Part IV and return directly to lender named in item 2.
The form is to be transmitted directly to the lender and is not to be transmitted through the applicant or any other party.

Part I — Request

1. To (Name and address of employer)
ATTN HUMAN RESOURCES
INSITUFORM TECHNOLOGIES INC.
1770 KIRBY PARKWAY STE. 300
MEMPHIS, TN. 38138

RECEIVED
OCT 17 1996

2. From (Name and address of lender)
HARBOR FINANCIAL MORTGAGE CORP
12225 GREENVILLE AVENUE, #123
DALLAS, TEXAS 75243
214-234-2300

I certify that this verification has been sent directly to the employer and has not passed through the hands of the applicant or any other interested party.

3. Signature of Lender	4. Title	5. Date	6. Lender's Number (Optional)
Melinda L. Boren	LOAN PROCESSOR	10/14/96	0910059

I have applied for a mortgage loan and stated that I am now or was formerly employed by you. My signature below authorizes verification of this information.

7. Name and Address of Applicant (include employee or badge number)
KEVAN CHARLES TAYLOR
501 DAVIS RD. #H201
LEAGUE CITY, TX. 77573
SS#412-75-8302

8. Signature of Applicant
X SEE ATTACHED AUTHORIZATION

Part II — Verification of Present Employment

9. Applicant's Date of Employment

10. Present Position

11. Probability of Continued Employment

12A. Current Gross Base Pay (Enter Amount and Check Period)
☐ Annual ☐ Weekly ☐ Other (Specify)
☐ Monthly ☐ Hourly
$

12B. Gross Earnings

Type	Year To Date	Past Year 1995	Past Year 1994
Base Pay	Thru ____ 1996 $	$ 29,042.80	$
Overtime	$	$	$
Commissions	$	$	$
Bonus	$	$	$
Total	$	$ 29,042.80	$

13. For Military Personnel Only

Pay Grade	
Type	Monthly Amount
Base Pay	$
Rations	$
Flight or Hazard	$
Clothing	$
Quarters	$
Pro Pay	$
Overseas or Combat	$
Variable Housing Allowance	$

14. If Overtime or Bonus is Applicable, Is Its Continuance Likely?
Overtime ☐ Yes ☐ No
Bonus ☐ Yes ☐ No

15. If paid hourly - average hrs. per week

16. Date of applicant's next pay increase

17. Projected amount of next pay increase

18. Date of applicant's last pay increase

19. Amount of last pay increase

20. Remarks (If employee was off work for any length of time, pleaseindicate time period and reason)

Part III — Verification of Previous Employment

21. Date Hired

22. Date Terminated

23. Salary/Wage at Termination Per (Year) (Month) (Week)
Base ____ Overtime ____ Commissions ____ Bonus ____

24. Reason for Leaving

25. Position Held

Part IV — Authorized Signature - Federal statutes provide severe penalties for any fraud, intentional misrepresentation, or criminal connivance or conspiracy purposed to influence the issuance of any guaranty or insurance by the VA Secretary, the USDA, FmHA/FHA Commissioner, or the HUD/CPD Assistant Secretary.

26. Signature of Employer	27. Title (Please print or type)	28. Date
Mary Ann Wilson	Payroll clerk	10/24/96

29. Print or type name signed in Item 26
MARY ANN Wilson

30. Phone No.
(901) 759-7423

employed 4/22/94 to 12/07/95
1994 records in storage

Fannie Mae
Form 1005 Mar. 90

VMP -23 (9007).04

VMP MORTGAGE FORMS - (800)521-7291

April 05, 1995

Mr. Kevan Taylor
3226 Knight Lane #258
Memphis, Tennessee 38115

Dear Kevan:

We have reviewed your lease agreement and find that your lease expired the first of March 1995. Your last rent payment was made on February 1, 1995, so there is no obligation on the Company's behalf to reimburse you for leasehold termination, since there was no penalty involved.

We have also received a rate quotation from Grabel Van Lines that includes shipment of a car back to England. This was not part of your agreement when you transferred to the USA and we are not responsible for shipment of your car back to England. Our agreement was the reasonable and customary charges for return of your household goods and personal items, which did not include shipment of a car.

I have issued a check request for reimbursement of $95.67 for a storage unit. Please let me know where to send the check.

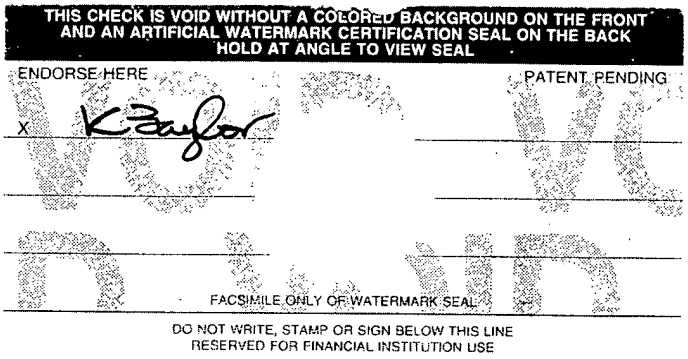
Sincerely,

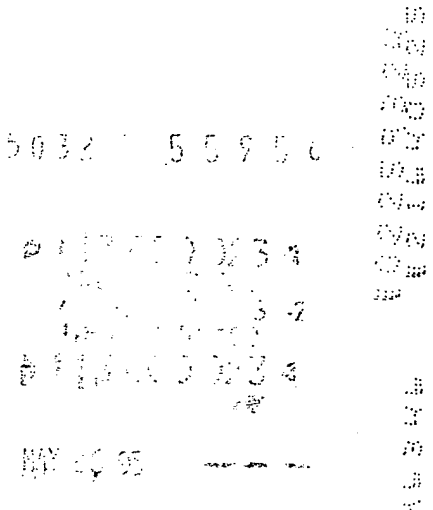
ck # _____

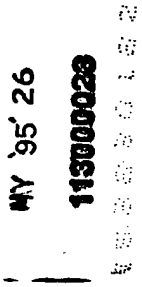
copy of check _____

Ann Hutcherson
Human Resource Manager

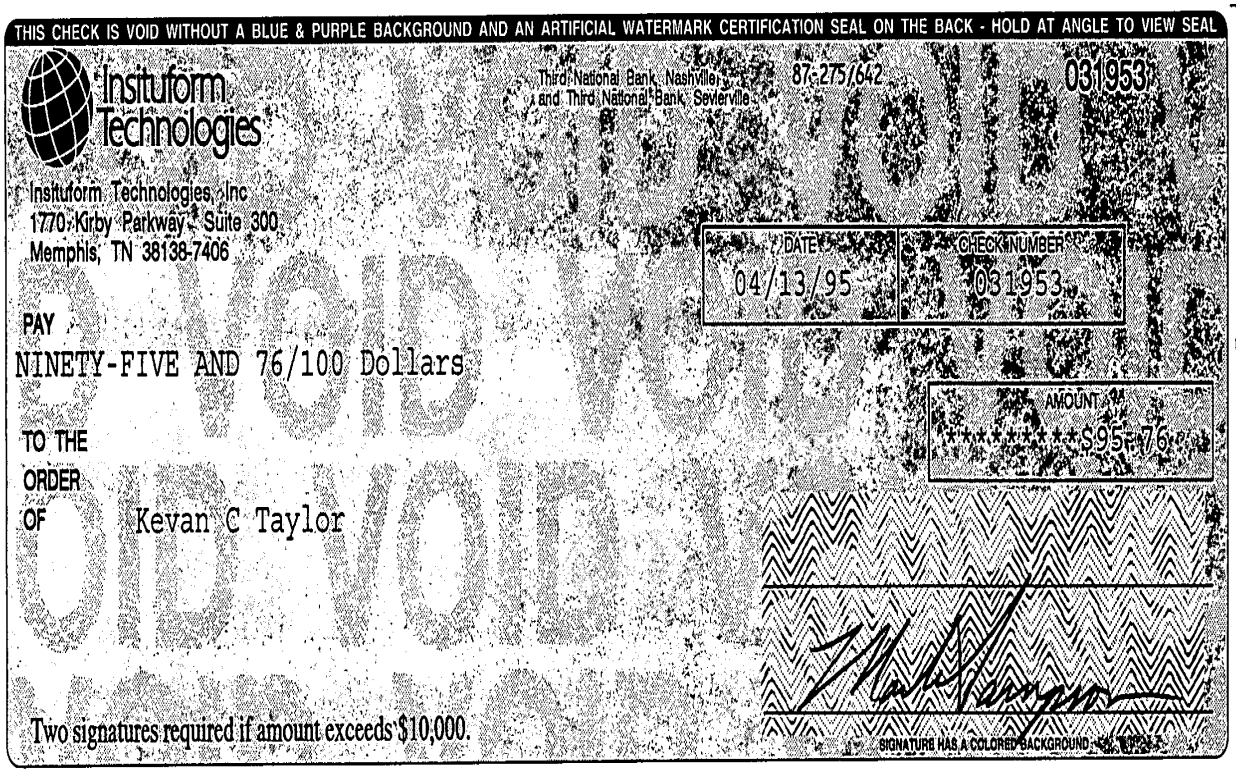
Enclosure







Best Available Copy



INSITUFORM TECHNOLOGIES, INC.
CHECK REQUEST FORM

DATE 4/5/95

MAKE CHECK PAYABLE TO: Kieran Taylor

PLEASE MAKE PAYMENT BY: __/__/__

INVOICE #: _____

CHECK AMOUNT $ 95.76

ACCOUNT # DISTRIBUTION: __-____-____-__-____

REASON FOR CHECK: Reimbursement for Storage Unit

ITI

VENDOR # _____ VOUCHERED BY: MAS

INVOICE # 040595 APPROVED BY: [signature]

INVOICE DATE 4/5/95

INVOICE AMT.: 95.76

DUE DATE: 4/13/95

ACCT # 630-6807 AMT.: 95.76

ACCT # _____ AMT.: _____

ACCT. # _____ AMT.: _____

SPECIAL INSTRUCTIONS:

Return check to A. Hutcherson;

THIS FORM IS FOR DISBURSEMENTS NOT APPROVED BY PURCHASE ORDERS

REQUESTED BY: _____

APPROVED BY: Ann Hutcherson